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SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1930.

HANNAH M. SMITH, Admrx. of the Estate of OWEN P. SMITH,
Petitioner,

v.

SPRINGDALE AMUSEMENT PARK, LTD., PAUL M. WILLIAMS and GERALD BROWN,
Respondents.

No. 315.

BRIEF FOR RESPONDENTS.

PAUL BAKEWELL,
Solicitor for Respondents.

St. Louis Law Printing Co., 415 North Eighth Street. CEntral 4477.

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BRIEF FOR RESPONDENTS.

STATEMENT.

We regret not to have been able to make this brief much shorter than it is, but we were unable to do so for the two following reasons:

(1) We cannot accept, as sufficiently full, clear and accurate, the statements as to facts and the propositions of law as applied to the true state of facts in this case, as we find the same set forth in petitioner's brief.

(2) As petitioner would seem to rely largely—we had almost said exclusively—on the specious but utterly fallacious opinion of the District Court in the case of Smith v. American Rabbit Racing Assn. (21 Fed., 2nd, 366) and on the action of the C. C. A. for the Fifth Circuit in agreeing with *"the conclusions"* reached by said District Court in that case (26 Fed., 2nd, 1016), we have felt constrained, not only to state the facts in and the history of the case at bar and of said case in the Fifth Circuit all with great particularity, but also to prove, as we believe we have succeeded in doing, that the said opinion of the District Court in said suit in the Fifth Circuit is utterly fallacious in its reasoning as well as in its conclusions, and that, consequently, the action of the C. C. A. for the Fifth Circuit in that suit, in agreeing with *"the conclusions"* of the District Court in that case and, for that alleged reason, affirming the interlocutory decree entered by said District Court in that case, was erroneous. Indeed, but for said action of said C. C. A. for the Fifth Circuit and the subsequent refusal of the C. C. A. for the Sixth Circuit, in the case at bar, to follow said Courts of the Fifth Circuit in that case, the instant case would not be before this Court.

At the October Term, 1928, of this Court, George W. Heintz and American Electric Rabbit Racing Association, who were defendants in the case in the Fifth Circuit, in which case the petitioner here was plaintiff (the decisions in which case are reported in 21 Fed., 2nd, 366, and 26 Fed., 2nd, 1016), in a suit under the identical Smith patents before this Court in the case at bar, petitioned this Court for writ of certiorari to the Circuit Court of Appeals for the Fifth Circuit; but said petition, in Case No. 449, October Term, 1928, was then denied by this Court (see 278 U. S., at page 626).

When we, as counsel for said petitioners in said case in the Fifth Circuit, petitioned this Court for the extraordinary writ of certiorari in that case, we did so for the reasons set forth in that petition, although, at that time, the C. C. A. for the Sixth Circuit had not yet rendered its opinion in the instant case now before this Court (the opinion in Smith etc., Appellant, v. Springdale Amusement Park, et al., found at R. 368, and also reported in 40 Fed., 2nd, 173).

At that time, apart from other reasons urged by us in support of said petition, the only opinion rendered in the instant case was that of Hickenlooper, J., rendered June 28, 1928, found at R. 89, and also reported in 39 Fed. (2nd), 92; so that, when said petition was presented to and denied by this Court, the then petitioners could not allege that there was then a conflict between the decisions of two U. S. Courts of Appeal (as could the plaintiff-petitioner in their petition to this Court in the instant case), but merely that the said opinion of Judge Hickenlooper, holding the District Court, S. D. Ohio, W. D., was in conflict with the opinion of the District Court (by Burns, J.) and the affirmance of the decree of said District Court by the C. C. A. for the Fifth Circuit in said suit against Am. Electric Rabbit Racing Assn., and the other reasons set forth in said petition, which petition this Court denied as aforesaid.

However, neither the mere denial by this Court of said petition in the case of Heintz et al. v. Smith (No. 449, October Term, 1928, see 278 U. S., at page 626), nor the mere granting of the petition for certiorari in the case at bar, in which latter case Hannah M. Smith, Administratrix, etc. is the petitioner, can be considered as equivalent to either an affirmance or reversal of the decree sought to be reviewed by either of said petitions for certiorari (see this Court in

Hamilton Shoe Co. v. Wolf Brothers, 240 U. S., at page 258).

Nor could it be successfully contended here by petitioner in the case at bar that the decree in said suit in the Fifth Circuit, in the case of Smith, Admrx. v. American Electric Rabbit Racing Association, Heintz et al. (reports of which case are found in 21 Fed., 2d, 366, and 26 Fed., 1016), is binding by way of estoppel on any of the respondents who are before this Court in the case at bar (Springdale Amusement Park, Limited, Paul M. Williams and Gerald Brown), for the following reasons:

(1) None of the respondents in the case at bar (Springdale Amusement Park, Limited, Paul M. Williams and Gerald Brown) was a party to, or in privity with any party to, said suit in the Fifth Circuit.

(2) The decree in said suit in the Fifth Circuit, as appears from the opinion of the District Court in that case (21 Fed. 2nd, 366) and from the record in that case brought here with said petition for certiorari in said case in this Court, No. 449, October Term, 1928 (see 278 U. S. 626), was an *interlocutory* decree for an injunction and accounting, not a *final* decree. And such a decree (an *interlocutory* decree) cannot be invoked as an estoppel even against the very parties to the suit in which such *interlocutory* decree was entered.

Simmons Co. v. Grier Bros. Co., 258 U. S. 82;
Luminous Unit Co. v. Freeman Sweet Co., 3 Fed. (2nd), at page 579 (C. C. A. Seventh Circuit);
Bassick Mfg. Co. v. Larkin Automotive Parts Co., 123 Fed. (2d), at p. 93, and cases there cited.

Moreover, although George W. Heintz was one of the several defendants in the said suit in the 5th Circuit

against the American Electric Rabbit Racing Assn. and was petitioner to this Court in the said case No. 449, October Term, 1928, in which this Court denied the petition for certiorari (see 278 U. S., at page 626), and although the same George W. Heintz was named as a defendant in the bill of complaint in the instant case (see R. 1), nevertheless said Heintz filed a motion to dismiss the bill as to him, which motion was sustained by the District Court, on the ground that said Heintz was not an inhabitant of the District and that it did not appear that he had committed acts of infringement, or that he had a regular and established place of business, in the District (see R. 89, and decree at R. 100); and the action of the said District Court in so sustaining the motion to dismiss the bill as to the said Heintz was never questioned by the plaintiff-petitioner and was not made a subject of any of said plaintiff's assignments of error (see R. 103-105).

Therefore, it follows: that the case at bar stands as a case against Springdale Amusement Park, Ltd., Paul M. Williams and Gerald Brown, as the only defendants-respondents in this case; and the only questions in this case relate to the validity of the three Smith patents in suit, and as to whether or not the said three last-named defendants, or any of them, infringed all, or any, of said three Smith patents.

It appears from the opinion of the District Court in the case at bar (Judge Hickenlooper's opinion, found at R. 89-99), when this case came on for final hearing in the District Court, on Feb. 20, 1928, it came on for hearing on the pleadings already in the case and on the motions to dismiss of the several defendants, as specified in the opinion of Judge Hickenlooper at R. 89, and on the evidence adduced at the trial, a statement of which evidence is found at R. 68-88; but it was understood by the Judge of the

trial Court and the counsel in the case, at the time this case was submitted to the District Court that, in the event any of the motions to dismiss made by the separate persons who had been named as parties defendant in the case should be overruled, then and in that event the separate answer of the Springdale Amusement Park, Ltd., found at R. 21-56, should be treated as the answer of such of the parties named as defendants in the case whose motions to dismiss might not be sustained by the District Court. With that understanding, the said answer of Springdale Amusement Park, Ltd., found at R. 21-56, was considered as also the answer of the defendants Paul M. Williams and Gerald Brown, whose motions to dismiss were overruled by the District Court in its said opinion, rendered after the final hearing of the case (see opinion, at R. 89, and decree, at R. 100, which decree also finds that none of the claims in issue of any of the three patents in suit had been infringed by any of the defendants before the Court, and dismissed the bill of complaint).

There is and has been no dispute in regard to these matters, and we simply refer to them here so that this Court may understand the situation as it actually existed and how and why it so happened, in the circumstances, that no separate and specific answer was filed in this case by said defendants, Paul M. Williams and Gerald Brown.

PATENTS DECLARED UPON IN THE BILL.

The bill of complaint in this case, which was filed on Aug. 19, 1927 (R. 1-13), declares upon and charges infringement of no less than eight patents, all of which were granted to the same Owen P. Smith.

One of these patents (Smith patent 1,038,504, of Sept. 10, 1912), found at R. 276, is a patent of which we shall

have something to say later on in this brief. Concerning said Smith patent 1,038,504, the bill, after referring to said patent by its number and date (see R. 2) states:

> "The devices of said patent made, used and sold by said Owen P. Smith and said plaintiff have been marked 'Patented', or with suitable abbreviation thereof, together with the date of said patent."

And in the bill of complaint in this case, after referring to and pleading the eight Smith letters patent declared upon in the bill, the bill states, in Clause 11 thereof, at R. 8, as follows:

> "The said inventions or improvements of said letters patent, respectively, are capable of conjoint use as well as separate use and have been used conjointly as well as separately by plaintiff and said Owen P. Smith in various parts of the country," * * *

After the answer in this case had been filed on Sept. 27, 1927 (R. 21), the plaintiff was interrogated by defendant by the formal interrogatories found at R. 56-58 and by specific reference to the eight Smith patents declared upon in the bill, as to which of the said several eight patents the plaintiff would rely upon at the hearing, and for plaintiff to state what claim or claims of any of the eight Smith patents declared upon in the bill plaintiff would rely upon at the hearing. The said interrogatories were filed on Sept. 28, 1927—the day after the answer in the case had been filed. Afterwards, on Oct. 26, 1927, plaintiff filed its answer to said interrogatories, stating as follows (see R. 60):

> "Plaintiff will rely upon all four claims set forth in patent No. 1,379,224, upon the three claims of patent

No. 1,507,440, and upon the single claim of patent No. 1,507,439.

Plaintiff will not rely on any other patents or any other claims than those above mentioned.

Plaintiff will not rely upon patent No. 1,038,504, or upon patent No. 1,410,842, or patent No. 1,591,569, or patent No. 1,630,811, or patent No. 1,638,112."

In other words, although plaintiff had deliberately declared upon and charged infringement of said eight Smith patents, after the defendants' answer had been filed and on Oct. 26, 1927 plaintiff solemnly declared in its verified answer to defendants' interrogatories that, at the final hearing of the case, she would rely only upon three of the Smith patents declared upon in the bill, namely, Smith patent 1,379,224; Smith patent 1,507,439 and Smith patent 1,507,440, and that plaintiff would not rely upon any of the other five Smith patents declared upon in the bill.

It should also be noted here that, although in plaintiff's said answer to defendants' interrogatories plaintiff, by her counsel, announced that she would rely upon *all four* claims of patent 1,379,224; nevertheless, at final hearing, as appears from the opinion of the District Court, at R. 89, and from the decree of the District Court at R. 100, plaintiff relied only upon Claims 1 and 2 of Smith patent 1,379,224.

THE THREE SMITH PATENTS IN SUIT,

Nos. 1,379,224; 1,507,439 and 1,507,440.

We shall consider the three Smith patents in suit in the order of their dates and numbers, with the purpose of ascertaining, in each instance, what is the particular; alleged invention illustrated and described (disclosed) which Smith *particularly pointed out and distinctly claimed as*

his invention (as required by Sec. 4888 R. S. U. S.) *by the claims in issue of said patents.* This is a most important thing to do, because the very basis or consideration justifying the grant of letters patent for an invention is a full and complete *disclosure* by the patentee, in the specification and drawings of his patent, of the thing which he *claims* as his invention.

> Merrill v. Yeomans, 94 U. S., at page 573;
> Bates v. Coe, 98 U. S., at page 39.

As the C. C. A. for the Second Circuit aptly puts it, in Typewriters Hilliardized v. Corona Co., 43 Fed. (2nd), at page 964:

> "Of course, a patent creates a monopoly in nothing not both *described* and *claimed.*" (Italics ours.)

The drawings, specification and claims of this Smith patent No. 1,379,224, dated May 24, 1921, applied for Sept. 4, 1919, are found at R. 186-192c.

In the case of this Smith patent, as is also true of the two other Smith patents in suit, though the drawings illustrate, the specification describes and the claims define *only one particular construction of device,* nevertheless the specification, as the same was originally filed in the Patent Office, as is also true of the specification of the patent as granted (see R. 156 and R. 189), contains words to the effect *that the invention is not restricted to the details of construction disclosed by the drawings and specification.* And, because of similar statements in the specification of all three of the Smith patents in suit, counsel for petitioner contend in their brief here that, notwithstanding what is illustrated and described in the drawings and specification and particularly specified in the claims in issue of said

patents respectively, nevertheless the fact that such general statements remained in and are found in the said Smith patents as granted, *ergo* it follows: (a) that the claims may be so construed as to read out of them elements or conditions expressly specified therein; or (b) that the claims are not to be read in the light of the particular structure illustrated and described in the drawings and specification but must be *enlarged*, by reason of such general statements in the specification as those which we have italicized above.

Such contention is not only fallacious, involving, as it does, a *non sequitur*, but also because, by the decisions of this Court and what this Court says in Railroad Co. v. Mellon, 104 U. S., at pages 118-119, and cases there cited, in respect to precisely the same situation as that shown to exist with respect to the history in the Patent Office of each of these three Smith patents in suit, this Court has met and refuted precisely such fallacious contention.

This Court there holds (see 104 U. S., at pages 118 and 119):

(1) That "the scope of letters patent should be limited to the invention covered by the claim, and that though the claim may be *illustrated*, it cannot be *enlarged* by the language used in other parts of the specification." (Italics ours.)

(2) That where the drawings and specification illustrate and describe, and the claims, *read in the light of the thing illustrated and described*, clearly show that what the patentee had invented and *actually disclosed* by his patent is a thing of a particular construction—a particular means of effecting a certain result—the mere fact that there remains in the specification of the patent as finally granted

any such vague or general statement as that which we have set forth above is of no avail to the patentee. Notwithstanding any such vague or general statement in the body of the specification, *what counts is the claim, read in the light of the thing illustrated in the drawings and particularly described in the specification.*

Hoping, by the above statement, to save the Court's time (as the above principles apply to all of the three Smith patents in suit) and at once meet the fallacious contentions with which petitioner's brief is so pregnant, we shall now, with more profit, we believe, be able to point out the particular thing—the only particular thing—*disclosed* by the Smith patent No. 1,379,224 and claimed by Claims 1 and 2 thereof.

By referring to this Smith patent, either to a printed copy thereof, which we trust the Court will have before it at the argument, or to the drawings and specification of that patent as reproduced at R. 186-192c, the Court will see that in Fig. 1 is illustrated a plan view of a track for dog racing. The track or race-course as illustrated is elliptical in form, as is the case with tracks for horse racing, although, of course, it might be of circular formation, and, as described in the specification and illustrated in Fig. 1 of this drawing, an electrically operated car is provided to run on rails and be enclosed in a housing for the purpose of concealing the car from the view of the hounds during the race and for protecting the electrically operated car from exposure to the elements, as illustrated in Fig. 2 of the drawing. As described in the specification, the tracks, housing or casing and the car, while it travels around the race course, are all located on the *outer* side of the race course, so that (see right of Fig. 1 at the upper part of said figure) after the car, which carries the fixed, projecting arm with a wheel at its outer end and the rabbit

located above the wheel (see Fig. 2), has made a complete course around the track, the car is switched onto a side track and entirely outside of and away from the housing or casing; and, when this is accomplished, a door closes behind the car, and thus the car with its projecting lure carrying arm and wheel are completely removed from the race course proper and disappear from the view of the hounds.

Inasmuch as the only claims of this Smith patent which are in issue in this case are claims 1 and 2, which claims have to do with a combination of elements consisting of a race course for dogs, a casing or housing extending around the *outer* side of the race course, a track for the car to run upon, and an arm carried by the car and extending horizontally from the car over the track and adapted to carry a lure, the said arm being *hinged* to the car at the inner end of the arm and provided with a wheel at the outer end of the arm, the supposed invention the subject-matter of Claims 1 and 2 having nothing to do with friction brakes, tripping mechanism etc., which are the additional features of the supposed invention entering into the combinations of devices claimed in Claims 3 and 4 of this patent, we shall confine our discussion of this Smith patent to the arrangement or combinations of elements the subject-matter of Claims 1 and 2, and particularly to the supposed invention as illustrated in Figs. 1, 2 and 3 of the patent.

After stating the general objects of the invention and referring to what the particular figures of the drawings illustrate, the specification of the patent states that the race track or course for the dogs may be *"circular, oval, kite-shaped, or any similar shape"*; that the race track is fenced in on one side by the fence 31, which fence, as appears from Fig. 1 of the drawing, is located on the *inner*

side of the track. On the other side (*the outer side*) of the race course (see Fig. 1), there is an enclosure or housing or casing, 31-a (see Fig. 2), which, as shown and described in the specification of the patent and as particularly specified in Claim 1 of the patent, extends around the *outer* side of the race course. There is a reason, in the principle of operation and construction of the particular device illustrated and described in this Smith patent, for locating this housing or casing, in which the car which carries the lure is encased during its course around the track, at the *outer* side of the race course, and it is this: That, as described in the specification of the patent and as the operation of the device is described in the patent, after the car with its projecting arm, lure and wheel has once made its complete course around the track, it is shunted off onto the switch shown at the right-hand top of Fig. 1 and completely outside and away from the race-course, as we have before stated.

This Court will take judicial notice of all matters of common knowledge, as for example, in the case of Brown v. Piper, 91 U. S. 37, it took notice of the construction and principle of operation of the ordinary ice cream freezer. Similarly, we submit, this Court may take notice of the fact that where there is question of running a car on wheels on a track, at the curves, in order to prevent the car by its momentum from leaving the track, the outer rail is invariably placed at a little higher level than the inner rail. That is true in the matter of railroad construction generally and would be inevitably true, although this Smith patent does not specifically refer to that fact, in respect to the device of the Smith patent, when making the curves on the track illustrated in Fig. 1 of the Smith patent. Therefore, Smith, manifestly having in mind such a construction and also one in which, at the end of the course, the car

was shunted onto the switch above referred to, was concerned with the manifest proposition that, as the outer rail would have to be a little higher than the inner rail, at the curves, the tendency would be, when the car was located on the *outer* side of the race course, as illustrated and described in his patent, if the arm which carries the lure were rigidly fastened to the car at the inner end of the arm and not *hinged* as illustrated, described and claimed,, and not provided with a wheel at its outer projecting end, when the car struck the curves, or if there was any irregularity in the bed of the race course, there would be danger of the outer end of the arm, which carries the lure, coming in contact with the ground and thus damaging the arm or breaking it off. This is manifestly the reason why, in the drawings and specification which provide for locating the car, housing or casing etc. on the *outer* side of the race course, Smith (see particularly Figs. 2 and 3 of the drawings) not only clearly illustrates and particularly describes the inner end of the arm as *hinged* to the body of the car, so as to permit some play and upward and downward movement to the said arm, but also describes and illustrates the said arm as *provided with a wheel at its outer end, to support the arm at the projecting end thereof*, and why he also describes and illustrates, just above the numeral 13 in Fig. 2 of his patent, a spring attached at one end to the inner end of the arm and at the other end to the body of the car, so as to tend to keep the arm down, *so that the wheel at the outer end thereof shall keep in contact with and rotate upon the bed or surface of the race course.*

In the specification of this patent, at R. 191, it is stated:

> "At 25, on the side of said car toward the dog race course, I have hinge-mounted the arm 26 extending

through the opening between the side boards 10 and 13 of the housing, and out towards the middle of the dog race course. Near the outer end of said arm I have mounted a wheel 28, preferably with rubber tire to rotate on the ground, and support the end of said arm 26. Above said wheel I have provided a platform 27 for mounting upon it the lure 29 in shape of a stuffed rabbit or other suitable object to entice the dogs to chase it. At the point 40" (see Fig. 2) "I have connected to said arm 26 a spring, extending to and attached to the frame as shown, designed to hold the said arm, and the wheel at the end of said arm, down with the wheel in contact with the ground."

In Claim 1 of the patent it is specifically stated that the casing or housing extends "around the *outer* side of the race course", and although it is true that in Claim 2, the covered rail, track etc. is described as "*on one side*" of the race course, nevertheless, when that claim is construed in the light of the construction and operation of the device as illustrated and described in the patent, that "*one side*", on which the tracks, car and housing or casing are located, must be the *outer* side of the race course, or else the apparatus described and illustrated in that patent will not operate in the manner illustrated and described in that patent, *which operation and construction (see upper part of Fig. 1 at R. 186) contemplates, when the race is over, taking the car with its projecting arm, lure and wheel entirely outside of the casing or housing and entirely outside of the race course and onto the switch illustrated at the top of Fig. 1 of said patent.* The arm and lure of this Smith patent are *not "made to disappear into the casing by means of switching the car"*, as incorrectly stated at foot of page 4 of Petitioner's brief.

The importance of this, we believe, was not fully appre-

ciated by the Court of Appeals for the 10th Circuit in its decision in respect to this patent, probably because this point was not clearly brought out in that case, but it is an important point, having to do with the principle of construction and operation of the particular device illustrated, described and claimed by Claims 1 and 2 of this Smith patent, and explains, as we have endeavored to point out, why, in this device, Smith found it necessary (in point of fact this location of the casing at *outer* side is specifically claimed in Claim 1 and implied in Claim 2) to provide his device with a wheel at the outer end of the arm, so that the said wheel would rest upon the ground and support that arm at its outer end, and why he also found it necessary to *hinge* the arm. Also, the inevitable effect of placing his housing, tracks, car etc. on the *outer* side of the race course was to cause the hounds, in quest of the lure, to take the longer course on the track around the curves, thus also, especially at the curves of the course, keeping the hounds more in view of the spectators.

However this may be, the fact remains, as a reference to the specification and drawings and to Claims 1 and 2 of this Smith patent will show, that in Claim 1 he describes the casing or housing as extending around the *outer* side of the race course and the arm which carries the lure provided with a wheel rotatably mounted on and supporting the arm at the projecting end thereof, while in Claim 2 he describes this arm as *hinged* to the car and provided with a wheel rotatably mounted near the end of the arm and resting upon the ground. Indeed, although Claim 1 of this patent does not describe the arm as *hinged* to the car, nevertheless, it would seem that the hinging of the arm to the car must be an implied element or condition of Claim 1, as it is a positive element or condition of Claim 2, because an arm rigidly fastened to the end of the car and yet

provided with a wheel rotatably mounted on and supporting the arm at its projecting end would hardly accomplish the purpose contemplated by the Smith patent, as such a rigid, unhinged arm (the car, housing etc. being located at the *outer* side of the race course, as illustrated and described in the patent) might be broken off at the curves, or in meeting unevenness or obstructions on the race course.

As to the housing or casing in this Smith patent, which housing or casing forms an essential element of the combinations forming the subject-matter of Claims 1 and 2 of this Smith patent, that housing is described in the specification of the patent, about the middle of R. 190. This housing or casing of patent No. 1,379,224, illustrated particularly in Fig. 2 and described in the paragraph about the middle of R. 190, which is made an element or feature of Claims 1 and 2 of this patent, in general outline, although not in details of construction, and in its purpose of housing the conveyor car and tracks etc., is quite similar to the housing illustrated in Fig. 1 of Smith patent 1,507,440 (another one of the Smith patents in suit) but differs from the housing of said Smith patent 1,507,440, found at R. 254, in the following respects:

The housing shown in Fig. 2 of this Smith patent 1,379,224 and described at R. 190 has no adjustable stay rods, turn buckle etc., such as illustrated, described and claimed in said Smith patent 1,507,440, found at R. 254, for keeping the roof from sagging. The arrangement of the posts of the housings in these two patents is very similar, but in the housing of this Smith patent 1,379,224, as we have said, there are no adjustable stay rods, turn buckle etc. for tightening the roof in the event of sagging. Instead of that (see Fig. 2 of Smith patent 1,379,224 at R. 187, and described in the specification at R. 190) it is stated:

"For the purpose of supporting the roof 1ª of the housing, and the overhanging side toward the track, I have provided the brackets 6 mounted upon the inner sides of the posts 1, as shown, and I have also provided a truss rod 8 which is attached to the roof 1ª, passes over the top of the post 1, and is suitably anchored in the ground outside of the housing as at 9."

The claims of this Smith patent 1,379,224 which are in issue here are Claims 1 and 2, which we here recite, purposely italicizing certain portions of said claims, because the express conditions, limitations and elements named in the said italicized parts of the claims are entirely absent in defendants' device, as hereinafter pointed out and as admitted in petitioner's brief:

"1. In a dog racing amusement, a race course suited for dogs, a casing *extending around the outer side of the race course*, and provided with a longitudinal opening, a mechanical conveyor including a track extending around the race course and located within the casing, and a conveyor car mechanically operated upon said track and provided with an arm extending through the longitudinal opening of the casing in a projecting position over the track and adapted to carry a lure, *and a wheel rotatably mounted on and supporting the arm at the projecting end thereof.*

2. In an amusement, the combination of a race course suited for dogs, a covered rail track adjacent said course on one side, a conveyor car mechanically operated upon said track, a horizontally extending arm *hinged to said car* extending midway of said course, *a wheel rotatably mounted near the end of said arm, and resting upon the ground*, a platform supported by said arm and a lure or quarry mounted upon said platform for attracting the dogs."

The history of the application for this Smith patent (No. 1,379,224) is found at R. 153-192c. At R. 160 and

161 are set forth eight claims—the claims presented with Smith's application as originally filed. The claims, on those pages, which are crossed with a red mark (original Claims 1, 2, 3, 7 and 8) were all broader claims than any of the other original claims there set forth, or any of the four claims found in the patent as granted (see R. 192b and 192c), in that they failed to contain the same *number* of elements and *all* the conditions and requirements specified in original Claims 4, 5 and 6 (see R. 160 and 161), which claims were renumbered and ultimately became Claims 2, 3 and 4 of the patent (see R. 192b and 192c). Nor did said *original, registered and abandoned claims*, 1, 2, 3, 7 and 8, contain the same *number* of elements and *all* the conditions and requirements specified in Claim 1 of the patent as granted (see R. 192c). Claim 1 of the patent, with *all* the elements, conditions and requirements specified therein, was first presented with an amendment dated Nov. 9, 1920, found at R. 169, together with two broad claims, crossed with red ink on that page; it was originally marked "3", but after the broad claims found in that amendment at R. 169 had been rejected by the Patent Office Examiner, cancelled and abandoned, without appeal from the action rejecting them (as was also the fate of original, broad Claims 1, 2, 3, 7 and 8, found at R. 160 and 161), that claim was renumbered and became Claim 1 of the patent as granted (see R. 192b).

These four, narrow, restricted claims of the patent as granted—restricted and limited in terms, so as to cover the structure and principle of operation thereof as the same is illustrated by the drawings and described in the specification—consisting of *original* Claims 4, 5 and 6 (R. 160 and 161) and Claim 3 of the amendment of Nov 9, 1920 (R. 169), were not rejected or found fault with by the Patent Office, clearly because, in their number of elements, arrangement, location and condition of parts, *they were in*

harmony with the only machine illustrated in the drawings and described in the specification and with the principle of operation of that machine.

Moreover, as it is the province of the patentee "*to make his own claim and his privilege to restrict it*", as this Court holds in Fay v. Cordesman, 109 U. S., at page 421, reaffirmed in Hubbell v. United States, 179 U. S., at page 82; and, as the language of the claims here is clear and distinct, there can be no doubt that in and by the claims in issue here (Claims 1 and 2 of the patent), in pursuance of the letter and spirit of Sec. 4888 R. S. U. S., Smith did "*particularly point out and distinctly claim the*" • • • "*combination which he claims as his invention*"; and that if, in point of fact, he had actually invented more than what he *claimed* by his patent—if he has only *claimed* a part of what he invented—"*he is presumed to have abandoned the residue to the public*", to use the very words of this Court in McClain v. Ortmayer, 141 U. S., at page 424.

Nor is it profitable to inquire as to whether or not the Patent Office Examiner was right or wrong in rejecting the broad claims made by Smith (see R. 160; 161; and 169), which were afterwards cancelled and abandoned by Smith. Smith is bound by his action. If dissatisfied with the action of the Examiner in rejecting all but the narrow claims found in his patent, Smith should have pursued his remedy by appeal (see this Court in Shepard v. Carrigan, 116 U. S., 593, and Hubbell v. United States, 179 U. S., at page 83).

All the limitations, as to number of elements, location, construction and relation of parts, found in the claims of this Smith patent are, as we have seen and as the history of the patent shows, self-imposed limitations, imposed by the applicant himself and binding on the patentee. In the case of such limitation in the claim, especially when they are voluntarily made by the patentee, the patentee is

bound thereby. *"When a claim is so explicit, the Courts cannot alter or enlarge it"*, as this Court holds in Keystone Bridge Co. v. Phoenix Iron Co., 95 U. S., at page 278, which doctrine this Court has repeatedly reaffirmed, by express reference to the last-named case, as in Motion Picture Co. v. Universal Film Co., 243 U. S., at page 510, and in Minerals Separation v. Butte Mining Co., 250 U. S., at page 347.

The defendants' car, lure-carrying arm and housing (all located at the *inner* side of the race course) are shown in the photographs found at R. 140 and 141. It is true, as stated at page 4 of petitioner's brief, that it appears from the evidence that the above named devices of defendants, in their construction and principle of operation, are made in accordance with the dog racing amusement illustrated and described in the Creveling U. S. patent No. 1,481,313, found at R. 147. That fact, however, the Creveling patent being subsequent in date to said Smith patent, is of no consequence here, except this: that it is convenient to refer to the drawings and specification of the Creveling patent to better understand therefrom the particulars of construction of defendants' device and how defendants' device differs, *both in construction and principle of operation*, from the device of said Smith patent and from the structure *claimed* by Claims 1 and 2 (the claims in issue here) of said Smith patent.

Nor is it of any consequence, as the District Court in the Fifth Circuit seemed to think it was (see 21 Fed., 2nd., at page 369), that, when Creveling originally applied for his patent, he made claims that were too broad in scope, with the result that the Patent Office Examiner cited against such broad and subsequently cancelled claims things *disclosed* in this earlier patent to Smith. The Patent Office Examiner, in so rejecting Creveling's original broad claims,

did not and could not decide that the machine *disclosed* in Creveling's drawings and description *infringed* the Smith patent; for such is not the province of the Patent Office Examiner. All the Examiner could and did do was to point out, by reference to the prior art as disclosed by the Smith patent and other patents cited by him, that Creveling was then claiming too broadly (as Smith also had done, when applying for said Smith patent); but, when Creveling confined his claims to his particular construction of device (as Smith had previously been forced to do, too), then the Creveling patent was allowed and granted.

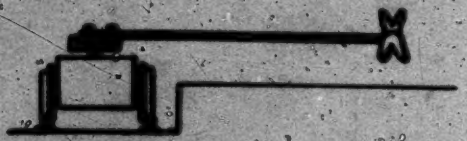
Turning then to the defendants' device, as illustrated in the photograph at R. 140 and 141, and even more clearly in the drawings of said Creveling patent, at R. 147 and 148, we find it to be one in which: (a) the car, its rails or tracks and the casing or housing are all located at the inner side of the race track (see Figs. 1 and 2 of Creveling patent at R. 147, and specification of Creveling patent, at R. 150); (b) that the lure-carrying arm is not provided, at its outer end, or anywhere, *with a wheel to support that arm at its outer end, or for any purpose;* (c) that the said arm is *not hinged* in any way to the car, or to any part thereof, so as to permit the arm to have some play and to be capable of some up and down or vertical movement independently of the movement of the car itself.

The defendants' device, in all the respects just tabulated above, differs, *in construction and principle of operation,* from the device illustrated, described and claimed in said Smith patent No. 1,379,224.

To illustrate, graphically, difference in construction and principle of operation between the device of defendants and that of this Smith patent, we illustrate in the drawing on the opposite page, in a diagrammatic way, on one side of the drawing the car of the Smith patent with its *hinged*

DEFENDANT'S CAR

CATED ON INNER SIDE OF RACE TRACK.

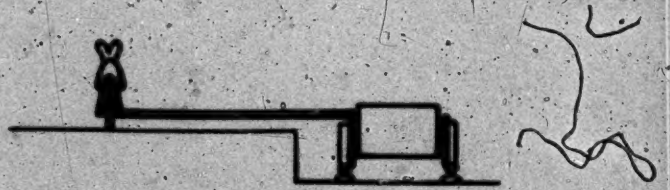


DEFENDANT'S CAR
ON STRAIGHTAWAY

DEFENDANT'S CAR
ON CURVE

SMITH CAR

LOCATED ON OUTER SIDE OF RACE TRACK.



SMITH CAR
ON STRAIGHTAWAY.

SMITH CAR
ON CURVE

lure-carrying arm attached at its inner end to the car and provided with a wheel at its outer end, in one instance on the straight-away of the race course and in the other instance on the curve. On the opposite side of the same drawing is depicted the defendants' car with the inner end of the arm *rigidly* fastened to a disk on the body of the car, carrying the lure at its outer end *but without any wheel*. The defendants' car, rails, etc. are located on the *inner* side of the race course. The defendants' car, rails etc. are also shown in the position which all these various parts take on the straightaway and also on the curves, in contrast with the device of the Smith patent in which the car, rails, etc. are all located on the *outer* side of the race course.

Instead of being *hinged* to the car (as is true of the device of said Smith patent), the lure-carrying arm of defendants' device is *rigidly* fastened at its inner end—by means of bolts—(see photograph at R. 141 and Fig. 5 of Creveling patent at R. 148) to a disk 30 on the chassis of the car, as admitted by petitioner's expert, Keene (see R. 71; 73; 75 and foot of R. 76 and R. 77). The particular construction of defendants' device in this respect and how it operates are thus stated in the specification of the Creveling patent, at R. 151:

> "As shown in Fig. 5, a stationary disc 28 is fixedly secured upon a yoke 29 rising from the chassis 17 and suitably secured thereto. Arranged in superimposed relation with respect to the disc 28 is a movable disc 30 mounted for rotational movement by means of a bolt 31 extending axially through both of said discs. The disc 30 forms a support for the arm A with the latter bolted thereto in the manner shown in Fig. 5 and extending radially therefrom with the lure L mounted on the outer end of the latter. The arm A and consequently the disc 30 is normally urged to a

retracted position with respect to the race track R and the slot 16 so that the lure is disposed within the housing H. This is effected through the medium of a coiled contractile spring 32 secured at one end to the arm A and at its opposite end to the chassis 17, all in the manner clearly shown in Fig. 3.

To maintain the arm A in projected position wherein the lure L is disposed directly above the track R, a latch 33 pivoted at the point 34 is adapted to engage within recesses 35 formed in the discs 28 and 30 so as to lock the disc 30 against rotation upon the disc 28. This latch 33 is normally urged to latching position through the action of gravity, but is adapted to be moved to releasing position by means of a trip 36 located between the track rails 15 and in the path of movement of the latch 33. The trip 36 is capable of tripping and non-tripping positions, and to this end it is mounted on a shaft 37 journaled in bearings 38 and provided with an operating crank 39 which can be extended to any suitable point for operation as will be understood from the consideration of Fig. 2."

In speaking of some of the differences in construction between the device of this Smith patent and defendants' device, petitioner's witness, Keene, who testifies to having built devices for the petitioner and Smith, points out, at the foot of R. 78, that, in the case of these dog racing devices, the car, which carries the arm and lure, travels at the rate of about forty miles an hour; that there is a disadvantage in having the arm *rigidly* connected to the car (as in defendants' device) over having it connected to the car as in the manner set forth in said Smith patent; and that, in the Smith device, the arm is supported by a movable support (a wheel) at its outer end. He there says: "I think that in the rigid arm, the vibration of the car will, in time, crystallize the arm and cause it to break off"

(R. 70, near foot of page). And on recross-examination, at R. 79, Keene states:

> "I say that it is my opinion that if the arm is rigid and not supported at its outer end by a wheel, that it would crystallize and break off by the vibration. As a matter of fact, I know it happened, because Mr. Smith tried the rigid arm and discontinued the use of it. I believe he found the rigid arm objectionable and that is why he put the wheel at the end, because the rigid arm was not satisfactory."

DEFENSES RELIED UPON BY RESPONDENTS AS TO SMITH PATENT NO. 1,379,224.

The defenses relied upon by respondents in the Courts below in the case at bar with respect to this Smith patent, as is also true with respect to the two other Smith patents finally relied upon by the petitioner at the trial of this case (the same defenses relied upon by respondents here) are:

(1) That, when the claims in issue of said Smith letters patent are construed in the light of the terms of said claims and in the light of the thing illustrated and described in (disclosed by) the drawings and specification of the letters patent, respondents' device does not infringe.

(2) If said claims, or any of them, be construed so broadly as to include within their scope the respondents' device, then the letters patent, as to any such claim or claims, are void for lack of patentable novelty and invention.

As stated above and to save repetition when we consider later herein the other Smith patents in suit (the *starting cage* patent No. 1,507,439, found at R. 222, and the *housing* patent, No. 1,507,440, found at R. 254), the same defenses

were made below and are urged by us here as to each of said patents. But, as to the said *starting cage* patent (R. 222), we also urged below, as we urge here, the additional defense that that patent is also void because the thing claimed by the single claim of that patent is merely a conglomeration—*a mere aggregation*—of elements, as distinguished from a true, patentable *combination* of co-operating elements.

THE PRIOR ART RELATIVE TO SMITH PATENT NO. 1,379,224—THE PATENT FOUND AT R. 186.

Before referring specifically to the patents of the prior art relative to this particular Smith patent, we wish to point out two things to the Court:

(1) That not one of the petitioner's assignments of error in the Court below (see R. 103-105) assigns as alleged error any ruling of the trial Court in the sustaining of objections made by defendants' counsel to questions put to witnesses or to proofs which petitioner's counsel sought to introduce in evidence. Clearly the trial Court was right in its rulings as to such matters; but, whether right or wrong, as this petitioner did not assign as error, on its appeal to the C. C. A. for the Sixth Circuit in this case, any such ruling by the District Court, no question can be raised by her counsel here as to the action of the trial Court in its rulings as to any such matters. Instances of such rulings by the trial Court are found at R. 70 and at R. 73 and 74.

(2) That there is no clear and definite proof that the particular alleged inventions, *the subject-matter of the particular claims in issue* (for the thing *patented* is the thing *claimed*) of all, or of any, of the *three* Smith patents

finally relied upon by the plaintiff went into any—much less any *extensive*—use. For it must be recalled, as the bill, answer and record referred to herein *supra* show, the bill, as filed, charged infringement of no less than eight Smith patents; that each and all of said eight Smith patents were alleged to be for *new* and *useful* inventions; that plaintiff and Smith had put the alleged inventions of each and all of said eight Smith patents into extensive use etc.; and that defendant had infringed each of said eight patents. The answer not only positively denies each and all of said allegations, as to each of said eight patents, and puts plaintiff to strict proof thereof (see for example clause "11" of answer, at R. 30), but positively denies infringement of each and all of said patents, and then pleads special defenses, as to invalidity etc., as to each of said patents.

Extensive use of the *very thing patented* (*claimed*) by a patent is no proof, *per se*, that the thing patented is an *invention;* it is, at most, only proof tending to show that the thing patented is *useful.* But, even to have the latter effect, the proof must be clear that the thing which the plaintiff has put to extensive use *is the very thing patented* (*i. e., claimed*) *by the plaintiff's patent.*

Commercial success, to be of any value in resolving doubt as to the patentable novelty of the thing claimed by a patent, must show that *the very thing of the patent* is the thing that went into extensive use and proved a commercial success. See Johnson v. Lambert (C. C. A. Second Circuit), 234 Fed., at page 889; and Haggerty v. Rawlings Mfg. Co. (C. C. A. Eighth Circuit), 14 Fed. (2nd), at page 930, citing Duer v. Corbin Cabinet Lock Co., 149 U. S. 216. Indeed, this must be true since the thing *patented* is the thing *claimed* (Leeds & Catlin v. Victor Co., 213 U. S. 301).

It is only necessary to examine the testimony of petitioner's witness, Keene, at R. 70, to note the objection of defendants' counsel then and there made and sustained (which action of the trial Court in sustaining that objection, or any other objection, is not assigned as error), and to the subsequent testimony of Keene, to see that, as to the *"35 or 38 tracks"* which Keene there refers to at the foot of R. 70, there is no *clear and definite* proof that those *"tracks"* embodied in their construction the particular device the subject of either Claim 1 or Claim 2 of this Smith patent No. 1,379,224 (the only alleged invention the subject of that patent which is in issue and of importance here). Keene's statements, at the foot of R. 70, must be taken in the light of Q. 16 on that page, which asks him to state *"approximately how many dog racing tracks are in existence in this country, not only operating under Smith's license, but anyone—all dog racing tracks."* The *inference* might be that some of those *"35 or 38 tracks"* there referred to by Keene might have embodied that particular construction; but neither *inference* nor *conjecture* is *evidence* of a fact put in issue by the pleadings. Nor does such very general testimony, in an attempt to prove that *the patented thing* went into extensive use, come up to the exacting requirements of the law laid down by the Courts in the cases last cited *supra.*

As to the other two Smith patents remaining in the suit (the *housing* and *starting cage* patents), there is not an iota of *competent and definite* proof in the record that both, or either, of them, as those alleged inventions are *disclosed* (*described* and *claimed*) in said patents, went into use at all. The only testimony in the record which, by any stretch of the imagination, can be said to relate to the use by Smith or petitioner of the devices of the Smith *starting cage* patent (No. 1,507,439) or to the use by Smith

or petitioner of the Smith *housing* patent (No. 1,507,440) is that of Keene, at the foot of R. 69, where, in answer to Q. 8, Keene says:

> "*The first two tracks that I worked on was under that old 1912 patent*" (the Smith patent No. 1,038,504, granted Sept. 10, 1912, found at R. 276—one of the eight Smith patents declared upon in the bill but which plaintiff did not rely upon at the trial—which we consider *infra* herein) "*but I built five under this 1921 patent*" (the Smith patent, No. 1,379,224, found at R. 186), "*including that starting cage and the housing. The places where I built these dog race tracks under the Smith specifications under the old 1912 patent*" (said patent found at R. 276) "*were first—one at the Madison Kennel Club, Fairmont City, Madison County, Illinois. The next one was the Hawthorn*" * * *.

This does not *clearly prove* that the particular constructions—the devices *as claimed*—in the three Smith patents in issue here went into use at all—much less that any of said devices, as *patented* (i. e., *as claimed*), by any *claims in issue* of any of said three Smith patents went into *extensive use.*

We shall now consider the patents of the prior art which have bearing on the dog racing amusement claimed by Claims 1 and 2 of Smith patent No. 1,379,224, dated March 24, 1921, applied for Sept. 4, 1919, found at R. 186.

As these prior art patents are readily understood by reading the specifications in the light of the drawings, "*no extrinsic evidence was given or needed to explain them*", to use the very words of this Court in Market Street R. Co. v. Rowley, 155 U. S., at page 625.

SMITH PATENT OF 1912, NO. 1,038,504.

The first patent of the prior art which we shall consider is this patent, No. 1,038,504, granted to this same Owen P. Smith on Sept. 10, 1912 (found at R. 276), granted and issued seven years before this same Owen P. Smith applied for his patent No. 1,379,224 (found at R. 186). This Smith patent of the year 1912 is one of the eight Smith patents declared upon in the *"duly verified bill"* (see R. 13, although, probably to shorten the record, the verification—the oath—to the bill has been omitted); nevertheless, as we have seen, before the trial, plaintiff, by her counsel, declared that she would *"not rely"* upon that patent or upon four other Smith patents pleaded in her bill (R. 60). Of that Smith patent the said plaintiff charged, under oath, in the bill (R. 2) that it is for a *"new and useful improvement in lure conveyors"* and (at R. 8, Clause 11 of the bill, and R. 9, Clause 13 of the bill) that Owen P. Smith and plaintiff *"up to the present time"* (the bill was filed Aug. 19, 1927, see R. 1) *"have made, used and sold the invention or inventions covered by the aforesaid several letters patent"* (this very Smith patent of the year 1912 and all the other seven Smith patents declared upon in the bill). This is also the same Smith patent to which plaintiff's witness, Keene, refers at R. 69, but which he tried to say was for an *"impractical"* device (see R. 73, foot), when we objected, on the ground that plaintiff was estopped to take such an inconsistent position on the record, and the trial Court sustained our objection (R. 74, top), which action of the trial Court was not only correct but plaintiff and her counsel conceded it to be correct—at least no exception to that ruling was taken at the time, nor was that ruling of the trial Court assigned as error on plaintiff's appeal. Clearly the trial

Court was right in sustaining our said objection, because plaintiff, in the circumstances, was estopped from taking an inconsistent position with respect to that Smith patent (Railroad Co. v. Mellon, 96 U. S. 528; Bigelow on Estoppel, 5th Edition, 673 and 717).

As the drawings and specification of this 1912 Smith patent (R. 276) disclose, the *"lure conveyor"* (the invention) of that patent is one in which there are present the following things, also found in the Smith patent No. 1,379,224 (R. 186): a casing or housing with a continuous opening or slot therein, through which continuous opening or slot a lure-carrying arm projects, at the outer end of which arm the lure is attached, the inner end of the arm being connected to the car; a motor car, which carries the aforesaid arm, being enclosed in the housing or casing, so that the car will be concealed from view and protected by the casing or housing; the said car traveling on rails, which rails are also located within the casing or housing.

The device of this Smith patent of 1912 (R. 276) differs from that of the Smith 1921 patent (R. 187) in that the housing, except at its extreme upper end, is completely located under ground and not partially located under ground as illustrated in Fig. 2 of said Smith patent of 1921 (R. 187), and that the said housing enclosing the car, tracks etc. is located in the race course itself, and not on the *outer* side thereof; and also in the fact that the continuous slot or opening in the housing through which the lure-carrying arm projects is at the top of the housing and not at one side thereof; and also in the fact that as the arm projects through the continuous slot in a vertical direction and not in a horizontal direction, it is not provided with a wheel at its outer end to support the outer end of the lure-carrying arm, as illustrated, described and claimed in the said Smith patent of 1921 (R. 187).

WALSH PATENT OF 1898, NO. 611,876.

This Walsh patent, dated Oct. 4, 1898, found at R. 264, *"for race track for dogs"* states, in the specification, that the race course is formed of *"one or more tracks"* and the specification expressly states (R. 266): *"but it is evident that a race course may be built with but one track"*. The drawing illustrates two tracks, described as arranged concentric to each other and enclosed by suitable fences. Outside the race course, concealed from view of the dogs by the fence, the tracks for the motor car and the motor car are placed. From the motor car D extends the lure-carrying arm or pole (where there are two race courses, as shown in the drawing there are two lure-carrying arms or poles). The lure-carrying arm or pole, whether there be one, or two as shown in the drawing, is described as extending in a *transverse direction* over the fence. This arm or pole, whether there be one, in the case of a single race track, or two as illustrated in the drawing, extends over the fence and part way across the race course *in a horizontal direction* (see parts marked E E′ in the drawing). As illustrated and described, the lure, in the form of a dummy hare, is not *directly* or *immediately* attached to the outer end of the horizontally extended arm. As shown in the drawings and described in the specification (see R. 265-266) a rope, rod or a pole is attached to the outer end of the said horizontal arm (see F in the drawing), and at the lower end of said rope, rod or pole is attached a support G, this support G being made of rubber, canvas or other suitable material, so as to readily conform to the undulations of the ground of the track. On this support G is secured the dummy hare H (the lure). In regard to this described and illustrated means of connecting the lure with the horizontal arm which, at its inner end is attached

to and projects from the motor car, the specification states, in the third paragraph at R. 266, *after stating that the race course may be built with one track*, as follows:

> "and it is also evident that other suitable mechanical means may be employed for pulling the support G rapidly along in the track for the animals to follow with the hare or dummy in plain view of the animals."

In other words, as the specification of this patent is addressed to those skilled in the art to which it relates, and therefore to persons of reasonable intelligence, the patentee leaves the matter of connecting the lure to the outer end of the horizontally projecting arm largely to the judgment or discretion of intelligent mechanics skilled in the art to which this particular patent relates. The patent contains five claims, found at R. 266 and 267, and while Claims 3, 4 and 5 bring into the combination the support for the dummy "*to be dragged*" along or in the track, Claims 1 and 2 contain no such limitation and cover the combination broadly, however the lure or dummy may be attached to or connected with the end of the projecting horizontally disposed arm, which arm is attached to and supported at its inner end to the motor car.

These things, in the light of what we have already said of this Walsh patent and in view of the fact that the Walsh patent, like all patents, is addressed to those skilled in the art to which it relates, would seem to clearly indicate that, at least as to two of the five claims of this Walsh patent, *Walsh did not intend to limit himself to any particular way of carrying the lure at the outer end of the projecting arm.* On any careful study of this Walsh patent of 1898 any one, at that time, while keeping within the scope of Claims 1 and 2 of that Walsh patent, in the light

of the disclosures of the patent, might readily have bent that horizontally projecting arm, at its lower end towards the bed of the race course, and attached the lure or dummy rabbit directly to the end of said arm.

The only other prior patents which we care to consider in connection with our discussion of Smith patent No. 1,379,224 are the Everett U. S. patent of the year 1913 and the British patent to Moss in 1896, which patents we shall now consider in the order just given.

EVERETT PATENT NO. 1,052,807 OF FEB. 11, 1913.

This Everett patent is found at R. 271. It illustrates and describes a race track and device to be used for racing dogs in pursuit of a dummy rabbit. It illustrates and describes an elliptical race course in which the operative mechanism is enclosed in a housing or casing having a continuous slot or opening therein at its top, through which opening a vertically arranged lure-carrying arm projects, the lure or dummy rabbit being attached to the outer or upper end of this arm. In this instance, as is also true with respect to the Smith patent of 1912 heretofore considered, the housing or casing with its continuous slot or opening therein, through which the lure-carrying arm passes, is located in the race course itself and about the center of the race course instead of being at the *outer* side thereof, as in the case of Smith patent 1,379,224.

MOSS BRITISH PATENT NO. 9,508 OF 1896.

This Moss British patent, with the specification and drawings thereof, is found in the record at R. 268-269, the drawing thereof being found at R. 269. In this Moss patent, as is also true of the Walsh patent heretofore discussed and found at R. 264, the electrically operated mechanism which carries the lure is controlled in its opera-

tion from the Judge's stand, as is the case with this Smith patent No. 1,379,224. The form of the track as illustrated in the drawing is elliptical, as in the said Smith patent at R. 186 and in the said Moss patent at R. 269. In the case of this Moss patent the drawing, at R. 269, shows, in Fig. 1, a plan diagrammatic view of the race track, and in Fig. 2 a detailed transverse section taken on the line x x of Fig. 1, taken through the body of the dummy animal propelled along the track or race course. The numeral 15 in Fig. 2 illustrates, in crossection, the body of the artificial lure or "dummy rabbit" carried by the adjacent mechanism illustrated in Fig. 2, and the latter mechanism, including the trolley wire 22, is protected and the dogs protected from coming in contact with the live trolley wire 22 by the hood 28 shown in cross-section in Fig. 2, in which hood, at the top thereof, is a continuous opening, to allow for the travel of the vertical member 29, all of which are illustrated in Fig. 2. The description of the construction and operation of these parts is set forth in the specification of this Moss patent at R. 268-a and 268-b as follows, reference being here made to the drawing at R. 269:

> "The track or rail on which the artificial rabbit 15 is impelled, is preferably in the form of a rail 16 disposed approximately medially between the walls 3 and 4, but also adapted to take a sinuous or wave course as seen in the diagrammatic view in Fig. 1, so that the dummy may imitate as closely as possible the course of the natural animal. The electric motor 17 forms part of or is carried by the dummy animal or rabbit, the shaft 18 of the motor carrying a terminal pinion 19 meshing with a gear-wheel 20 secured to or forming part of the travelling and supporting wheel 21 which has a peripheral grove embracing the rail. The current is led from the motor to the wheel 21 through the wire 31 when it is grounded through the

rail 16, the current first entering the motor through the trolley wire 22, trolley wheel 23, and connecting wire 24, the trolley wire receiving its current from the shunt wire 25 leading from any suitable central station. The grand stand is provided with a switch mechanism 26 by the turning of the lever 27 of which to different degrees or notches, the intensity of the current propelling the rabbit can be varied, thus varying the speed of the rabbit. The race is made the more interesting in that the speed of the dummy rabbit can be increased to such a degree that the dogs will never overtake the dummy; and to avoid any danger of the dogs coming in contact with or overtaking the dummy, they are cut off by the swinging gate at the proper moment and made to enter the kennel located in the center field.

To avoid any danger of the dogs coming in contact with the live trolley wire, I cover the full length of the wire with a hood 28 of wood or other nonconducting material, the same being provided with suitable openings to allow for the fastening to the wire of the lower ends of the vertical members 29 depending from the guy rods 30 stretched at intervals between the walls 3 and 4 of the race course."

The prior art, relevant to the thing *patented* (*claimed*) by Claims 1 and 2 of Smith patent No. 1,379,224, as disclosed by the prior patents above considered, shows: that it is not correct to say, as stated at page 11 of petitioner's brief, that "*he*" (Smith) "*produced function*" (sic) "*never performed before, terminating in a new and useful result never achieved before—a successful complete dog race in pursuit of an inanimate lure*". Moreover, if that statement were true in point of fact, it would not be material here, since a patent is not valid for a mere *function* or *result*, but merely for *the particular means* claimed in the patent by which a certain *function* or *result* is accom-

plished (Corning v. Burden, 15 How. 252; Westinghouse v. Boyden, 170 U. S., 537, and Minerals Sep. Co. v. Butte Mining Co., 250 U. S., at page 349).

Nor is it established, on this record, *by competent, clear proof*, that the thing patented by Smith, by Claims 1 and 2 of his said patent of May 24, 1921 (for the thing patented by those two claims of that patent is the alleged invention of that patent which is in issue here) resulted in the first *"successful dog race in pursuit of an inanimate lure"*.

The mere fact that Petitioner's witness, Keene, *"had never heard of, or seen, a dog race prior to 1921, and this dog racing patent"* (see R. 74) is of little consequence and does not *prove* the said assertion in petitioner's brief. Nor is such a fact, if it were a fact, proved by the dog fancier, Morley, who resides at St. Louis, has been to New York, Illinois, Massachusetts and Rhode Island, whose testimony is found at R. 83; nor by what Strout, a waiter and breeder of canaries, says at R. 84; nor by Spencer, whose testimony is found at R. 84 and 85. And yet, in the testimony of the said witnesses are to be found *the only statements in the record* which, only by a stretch of the imagination, can be construed as tending to support the said assertion in petitioner's brief.

The patents prior in date to said Smith patent No. 1,379,224 of May 24, 1921, which prior patents we have referred to *supra*, are relied upon by us, as they were also pleaded in the answer, at R. 38 and 39, "for the purpose of assisting the Court in interpreting the claims of said Smith patent and also for the purpose of showing want of patentable novelty and invention in the thing claimed by any claim of this Smith patent relied upon by plaintiff in this case"; and also as prior patents, or prior publications, within the meaning of Sections 4886 and 4920 R. S. U. S.

In such circumstances and under said statutes, it is not

necessary to show that any one particular patent illustrates or describes the exact combination claimed by the claims in issue of the patent in suit; it is all sufficient that, in the light of what is disclosed by the various prior patents put in evidence by defendant, the thing which plaintiff's patent *claims* (or, in this case, the thing which plaintiff contends her patent covers) *did not rise to the dignity of patentable invention* (see this Court, in Concrete Appliance Co. v. Gomery, 269 U. S., at pages 179-180, and 184-185, and in Duer v. Corbin Cabinet Lock Co., 149 U. S., at page 222).

If, as is urged in petitioner's brief, page 7 thereof, Claims 1 and 2 (the only claims of that Smith patent in issue here) be construed so as to cover "*all other forms which embody the substance of a lure-carrying arm horizontally extending from the conveyor through a continuous longitudinal opening of the casing located on either side of the race course*", then, in view of what is disclosed to those skilled in the art by the prior patents considered *supra*, we contend that said Smith patent, as to the said claims thereof in issue here, is void *for lack of patentable novelty and invention.*

Nor is it true in respect to any of the prior art patents heretofore considered in this brief in connection with said Smith patent 1,379,224, or with respect to prior art patents hereinafter considered in respect to the two other Smith patents in issue here, that, as is in effect stated in petitioner's brief at page 13 thereof, the burden was on these respondents to prove that the devices disclosed by all, or by any, of the prior patents in evidence were actually put into successful use.

Such a contention not only utterly ignores the provisions of Secs. 4886 and 4920 R. S. U. S., but is in direct contravention of what this Court has expressly decided; it puts a burden on the defendant in a patent case which, under the

law, he is not required to carry. As has already been noted and as reference to defendants' answer in this case will show, as to this particular Smith patent, as well as to each and all of the Smith patents in suit, defendants pleaded the prior patents not only as *patents* but as *prior publications*, to show lack of patentable novelty and invention in the things claimed by the claims in issue of the Smith patents in suit. As to the devices illustrated and described in any such prior patents the defendants did not plead *prior use* of such devices, because under Sec. 4920 R. S. U. S. "*prior use*" is a distinct and separate defense from that of pleading prior *patents* or prior *publications*. But this matter has been settled, against the extraordinary contention found in petitioner's brief, by this Court in several cases.

In Pickering v. McCulloch, 104 U. S., at page 319, defendant had introduced in evidence certain prior patents for the same purpose as the prior patents introduced in evidence in this case were put in—*to show lack of patentable novelty and invention in the thing claimed by plaintiff's patent.* In that case, in answering the precise contention above referred to and made by the counsel for the plaintiff, this Court says, a part of the following quotation being purposely italicized by us, at p. 319 of 104 U. S.:

> "It is objected, however, that the machines described in these patents *are mere paper machines, not capable of successful practical working.* But on examination it sufficiently appears, we think, that the objections can be sustained only as to minor matters of detail in construction, not affecting the substance of the invention claimed, and could be removed by mere mechanical skill, without the exercise of the faculty of invention. *In this view, the Wise and Smith*

patents are not rendered inefficient as defences in this suit, by reason of the alleged imperfections of the machines described in them.''

See also Duer v. Corbin Cabinet Lock Co., 194 U. S. at pages 219 and 223.

In view of the above finding of this Court, just quoted from its opinion in Pickering v. McCulloch, and in view of what is disclosed, to those skilled in the art, by the prior patents hereinbefore considered, and in view of the broad terms of Claims 1 and 2 of the Walsh patent (see R. 266 and 267), it would, for instance, not have required the genius of an inventor but merely mechanical skill and adaptation to have bent the arm "E" described in that patent and illustrated in the drawing, at R. 264, and to have attached the lure directly to the outer end of that arm, as we have indicated *supra*. And, so far as a casing or housing with a continuous opening is concerned, through which continuous opening in the housing or casing the lure-carrying arm passes, that is fully disclosed, among other prior patents, by the prior patent to Smith himself of Sept. 10, 1912, at R. 276; and when there was question of placing the casing or housing and the motor car in its tracks on the outer side of the race course, as illustrated, described and claimed in the Smith patent in suit, No. 1,379,224 (R. 186), in view of the then condition of the prior art, it hardly required the genius of the inventor to recognize that, in such circumstances and under such conditions, when it was desired to place the lure-carrying arm in a horizontal position, it would be necessary to put the continuous opening in the casing or housing at the side instead of at the top of the housing, as shown in the Smith patent of 1912, at R. 276.

If Claims 1 and 2 of Smith patent No. 1,379,224 be given

the construction urged at page 7 of petitioner's brief, then and in that event the said patent, as to those claims, *is void for want of patentable novelty and invention.*

AS TO INFRINGEMENT OF CLAIMS 1 AND 2 OF SMITH PATENT NO. 1,379,224.

As already pointed out and as admitted in petitioner's brief at page 4, respondents' apparatus is constructed in accordance with the device as illustrated and described in the Creveling patent, found at R. 147. Defendants' device is also illustrated in the photographs at R 140 and 141. Defendants' device is not the device claimed by Claim 1 of this Smith patent, for two reasons:

(1) In defendants' device there is not present a housing or casing "extending around the *outer* side of the race course".

(2) In defendants' device there is not present "*a wheel rotatably mounted on and supporting the arm at the projecting end thereof.*"

As to Claim 2, defendants' device does not infringe that claim, because: in defendants' device the arm is not *hinged* to the car; and also because there is not present in defendants' device "*a wheel rotatably mounted near the end of said arm and resting upon the ground.*"

It should be noted that Claims 1 and 2 of this Smith patent No. 1,379,224, as is also true of the claims of the two other Smith patents in suit, No. 1,507,439 (the starting cage patent) and No. 1,507,440 (the housing patent), are claims for a combination of elements going to make up a supposedly complete machine. It so happens that the law with respect to the interpretation of claims for a combination of elements is correctly stated, as to each one of

the following propositions, in Walker on Patents, 6th Ed., Vol. 1, Sec. 411, at pages 498 and 499, the author, in stating the propositions contained in the following quotation, citing in his notes, as to each proposition, leading decisions of this Court, most of which we have referred to herein, either *supra* or *infra*:

> "Sec. 411. Omission of one element or ingredient of a combination covered by any claim of a patent, averts any charge of infringement based on that claim, whether or not the omitted ingredient was essential to the combination of the patent, and whether or not it was necessary to the operativeness of the device. And it makes no difference that another element is made to do the work of itself and of the omitted element. A combination is an entirety. If one of its elements is omitted, the thing claimed disappears. Every part of the combination claimed is conclusively presumed to be material to the combination, and no evidence to the contrary is admissible in any case of alleged infringement. The patentee makes all the parts of a combination material when he claims them in combination and not separately."

As the foregoing propositions set forth in Walker on Patents, 6th Ed., Sec. 411, would seem to meet and completely answer the sophistical arguments found in the brief of the petitioner in support of the proposition that respondent's device, notwithstanding its construction and notwithstanding the clear terms of Claims 1 and 2 of this Smith patent, nevertheless does infringe each and both of said claims, and because every proposition, as stated by the author in the quotation above given, is sustained by the decisions of this Court which he cites in his notes at the foot of that section, we respectfully submit that the above quotation from Walker on Patents, applied to the

facts as they exist in this case, amounts almost to a demonstration that the Courts below were right in the case at bar in holding that respondents had not infringed these Smith letters patent, because, in so doing, the Courts below, in the case at bar, followed the rules governing the interpretation of claims of letters patent for a combination of elements, as those rules have been repeatedly declared by this Court and in the very cases cited in the footnotes to Sec. 411 of the Sixth Edition of Walker on Patents.

SMITH PATENT NO. 1,507,439, DATED SEPT. 2, 1924, APPLIED FOR MAY 16, 1921, FOR STARTING CAGE FOR RACING DOGS.

The drawings and specification of this patent are found at R. 222-224a, and the history of the application for this patent is found at R. 193-209. This patent contains a single claim, limited to a mere conglomeration or aggregation of specially arranged or constructed features or elements. Such as it is, it took Smith and his attorneys more than three years to persuade the Patent Office Examiner to allow a patent for the so-called invention illustrated and described in that patent. The single claim of that patent, found at R. 224 and 224-a, is here set forth, although in quoting the claim we have purposely italicized certain portions thereof:

> "In a starting cage for racing dogs, a frame comprising a box-like structure divided into a plurality of compartments and *comprising walls formed of wire mesh partially covered with fabric,* individual rear doors for each of the compartments and a single front door hinged at its upper end to the top walls of the frame, *divergent inclined* members secured to the top of the said frame and extending upwardly and out-

wardly beyond the face of the front door and *having their outer ends in the plane of the side walls of the box-like structure,* springs secured to the outer ends of said inclined members and to the door and lying in the plane of the hinges, and a latch at the bottom of the cage for coaction with the lower edge of the front door to hold the front door normally closed against the tension of said springs, said springs adapted to raise the front door upon release of the latch."

The defendants' starting cage, a rear view of which is shown in the photograph at R. 143 and front views of which (one with the door open and the other with the door closed) are shown in the photographs at R. 144 and 145. By reference to said photographs at R. 143, 144 and 145 it will at once be noticed, when comparing the thing shown in those photographs with the thing claimed in the said claim of this Smith patent, that the elements, features and conditions specified in those parts of the said claim which we have italicized are not present in the defendants' starting cage. In the defendants' starting cage the dog stalls are divided one from another, as hog, horse or cow stalls have been divided from time immemorial, i. e., by boards placed on edge one above another, so as to make closed partitions between each animal. At the rear of each stall there is a door which is opened or closed by lifting it up by hand or pushing it down by hand, as illustrated at R. 143. The front of defendants' starting cage, shown with the long front door open at R. 144 and with the same front door closed at R. 145, is hinged at the top and provided with a latch at the front, as was common and well known from time immemorial, when there was question of providing a door for a box or house for any animal and it was desired to allow the door to be hung from the top instead of the side.

It will also be noted, by comparing the photographs at R. 144 and 145 with the device illustrated in the drawings of this Smith patent at R. 222 and with the starting cage described in the specification of the patent and claimed in the single claim of the patent, that, while in the starting cage as illustrated, described and claimed in this Smith patent, the members, beams or timbers 9 9 of the patent are "*divergent*" (see Fig. 1 of the patent, at R. 222) and have their *outer* ends in the plane of the side walls of the box, in defendants' starting cage (see R. 144 and 145), the three beams or timbers there illustrated are not "*divergent*", are in each instance placed at some distance inwardly from the side walls of the box and do not have their outer ends "*in the plane of the side walls*", as illustrated, described and claimed in this Smith patent. This, of itself, in the light of the decisions of this Court cited *supra* and *infra*, would seem to clearly show that defendants' starting cage does not infringe the single claim of this Smith patent.

It will be noted when Smith filed his original application, he filed with it three claims, found at R. 197 and 198, all of which were rejected, and, in pursuance of said rejection, cancelled and abandoned; that afterwards, on Feb. 28, 1922, he presented the claim found at R. 222, which claim did not contain all of the elements and conditions found in the claim of the patent as granted. That claim was rejected and afterwards cancelled and abandoned by Smith. Afterwards, on Oct. 28, 1922, Smith presented another amended claim, found at R. 202. That claim was also rejected, and it was not until, by the amendment of Jan. 16, 1924, found at R. 205 and 206, by inserting into that claim additional modifications resulting in the single claim found in the patent, that his application was allowed on June 25, 1924 (R. 209).

There can be no question, under the circumstances, that all the features, elements and conditions specified in the claim of the patent as we have quoted that claim above and found in the italicized portion of that claim as quoted by us (all of which italicized conditions or elements are entirely absent from defendants' starting cage) are of the essence of the alleged and pretended invention, the subject-matter of this patent; and defendants' device does not infringe, because it does not embody the particular structure claimed by this Smith patent. See the decisions of this Court in I. T. S. Rubber Co. v. Essex Rubber Co., 272 U. S., 429, 444, and in Weber Electric Co. v. Freeman Electric Co., 256 U. S., 668, 677.

We respectfully submit that if a twentieth century invention was imparted to the starting cage illustrated and described in this Smith patent by making an essential part of that remarkable invention consist in dividing the compartments or stalls for dogs by means of "*wire mesh partially covered with fabric*" (and this is made an essential element or condition of the thing claimed in the patent), such a thing is not present in the starting cage of defendants. We hardly believe that in this twentieth century it took the genius of an inventor to make the partitions of a dog cage of wire mesh and to partially cover the wire mesh with fabric; nevertheless, that element or feature, which is entirely absent from defendants' starting cage, was presented as an essential condition or element in the claim of the patent, and it would seem that its presence in the aggregation of things claimed by the claim of this Smith patent was one of the things which finally persuaded the Patent Office to resolve doubts of novelty and invention in favor of allowing this Smith patent containing the extraordinary claim found therein and hereinbefore quoted.

As to non-infringement, we firmly believe there can be

no doubt whatever. On the other hand, it would seem clear, when the decisions of this Court in analogous cases and the principles announced therein are appreciated and understood, that the thing *claimed* and thus *patented* by this Smith patent is utterly destitute of patentable novelty and invention, in the light of matters of which this Court will take judicial notice. Applying to the facts in this case the principles announced by this Court in Concrete Appliance Co. v. Gomery, 269 U. S., 179-180; 184-185, it would seem that the thing patented by this Smith patent amounts, at best, merely to mechanical skill, and mechanical skill of a very low order at that, and does not rise to the dignity of an invention within the meaning of the patent law.

The patents to Stitzer (R. 330); to Stedeker (R. 338); to Andrew (R. 318); and to Whitehead (R. 311) all show starting devices for race courses in which one feature or the other, or many of them combined, found in the said Smith patent are present. Those starting devices for race courses show, in various forms, means such as doors or barriers suddenly opened or removed from in front of the animals, to permit them to leave the enclosure and start out for the race. They also show stalls or partitions, some of them made of wire mesh and some of them covered with fabric, to prevent injury to the animals while in the stalls. The aggregate of what those various patents disclose to those skilled in the art of constructing devices for races would seem to show want of patentable novelty and invention in the thing claimed by this Smith patent within the meaning of the decisions of this Court in such cases as Duer v. Corbin Cabinet Lock Co., 149 U. S., at page 222, and Concrete Appliance Co. v. Gomery, 269 U. S., at pages 179 and 180 and 184-185. But the nature of the thing disclosed and claimed by this Smith patent No. 1,507,439 presents another question in respect to what constitutes pat-

entable novelty and invention. It presents a question of a *mere aggregation of elements*, as distinguished from a true patentable *combination*. It would seem obvious that the *"walls formed of wire mesh partially covered with fabric"*, specified in the claim of this patent and illustrated in the drawings and described in the specification of the patent, in no way co-act with or modify or affect the operation of the rest of the elements or features of the starting cage claimed in that claim and illustrated and described in that patent. The front door of that patent, the latch, the springs and the divergent inclined members or timbers 9 9 of the patent will all operate in the manner disclosed in the patent whether or not there be present a plurality of compartments in the box or cage, and whether or not the walls of the plurality of compartments are *"formed of wire mesh partially covered with fabric."* The said walls, formed of wire mesh partially covered with fabric, would permit light and ventilation to pass through and from one stall or partition to the other and prevent the animals from being scratched by the wire and enable them to look at their companions through the upper part of the wire mesh whether or not the front door was hinged at the top and latched at the bottom, or hinged at the side and latched at the side, or whether or not, through the instrumentality of springs attached to the front door at the lower ends thereof and to the divergent inclined members at the upper ends thereof, the door was opened.

There is no more co-operation or true *combination* between the said *wire mesh partially covered with fabric* in the claim of the said Smith patent and the other features or elements of that combination than there was in the case of Reckendorfer v. Faber, 92 U. S., 347-356, between the eraser at one end of the pencil and the lead at the other, or than there was in the re-entrant bend of the roller shelf

and the other parts of the skeleton roller shelf in the case of the Hoffman patent No. 450,124 in the suit of Mfg. Co. v. Fenton, 174 U. S., 492, 498. Also see the decision of this Court in Grinnell Washing Machine Co. v. Johnson Co., 247 U. S., 426, 433.

It seems to us that the following excerpt from the opinion of this Court in Specialty Mfg. Co. v. Fenton Mfg. Co., 174 U. S., at page 498, is peculiarly apt here as showing that the claim of this Smith patent, in so far as it comprises as an essential condition or element thereof *"walls formed of wire mesh partially covered with fabric"* is not a claim for a patentable *combination*, but merely for a non-patentable *aggregation*, and therefore not for a *patentable invention* within the meaning of the patent law:

> "Putting the Hoffman patent in its most favorable light, it is very little, if anything, more than an aggregation of prior well-known devices, each constituent of which aggregation performs its own appropriate function in the old way. Where a combination of old devices produces a new result such combination is doubtless patentable, but where the combination is not only of old elements, but of old results, and no new function is evolved from such combination, it falls within the rulings of this court in Hailes v. Van Wormer, 20 Wall. 353, 368; Reckendorfer v. Faber, 92 U. S., 347, 356; Phillips v. Detroit, 111 U. S., 604; Brinkerhoff v. Aloe, 146 U. S. 515, 517; Palmer v. Corning, 156 U. S., 342, 345; Richards v. Chase Elevator Co., 158 U. S., 299. Hoffman may have succeeded in producing a shelf more convenient and more salable than any which preceded it, but he has done it principally, if not wholly, by the exercise of mechanical skill."

It inevitably follows, we submit:

(a) That defendants' starting cage for dogs does not infringe Smith patent 1,507,439; and

(b) That the claim of said patent is utterly destitute of patentable novelty and invention.

SMITH PATENT NO. 1,507,440, DATED SEPT, 2, 1924, APPLIED FOR MAY 24, 1921, FOR HOUSING FOR CONVEYOR CARS AND TRACKS.

This Smith patent is found at R. 254. In Fig. 1 thereof we find, in outline, the same shape and arrangement of parts illustrated in Fig. 1 of the prior Smith patent of 1921, No. 1,379,224 (one of the Smith patents in suit, found at R. 186). In both of these Smith patents we find the car with its rails, horizontal arm and *wheel at the outer end of the arm* and a housing—all described and illustrated as located at the *outer* side of the race course. In the said earlier Smith patent, found at R. 186, as has already been noted, in and by Claims 1, 2 and 3 of that patent, found at R. 192-b, the housing or casing, which is particularly illustrated in Fig. 2 of that patent at R. 187, *is claimed as a part of the combination the subject-matter of said claims.* The housing illustrated in Fig. 2 of that first Smith patent at R. 187 is, in all respects, identical with the housing illustrated in this Smith patent No. 1,507,440 at R. 254, except in the particular respects which we shall now point out.

In the housing of the said earlier Smith patent of 1921 the roof of the housing is not inclined, but would appear to be a straight flat roof. In the housing of that patent (see R. 187) and as that housing is described in the specification of that patent at R. 190, the roof of the housing is supported in the following manner:

"For the purpose of supporting the roof 1-a of the housing and the overhanging side toward the track, I have provided the brackets 6 mounted upon the inner sides of the posts 1 as shown, and I have also provided a truss rod 8, which is attached to the roof 1-a, passes over the top of the post 1 and is suitably anchored in the ground outside of the housing as at 9."

Now, the only difference in construction between this housing of the earlier Smith patent and the only housing illustrated and described in this Smith patent No. 1,507,440, found at R. 254, is that in the housing of this last named Smith patent the roof is slightly inclined towards the race course and *special means* are provided *for adjustment, to take care of any possible sagging of the roof and to keep the roof always at the desired elevation.* This latter is the only real and characteristic difference between the housing or casing of the two said Smith patents, and it is thus described in the specification of this Smith patent No. 1,507,440 at R. 256:

"For supporting the inner edge of the roof, and the inner side of the housing above the opening 14, I have provided truss rods as 12" (see Fig. 1 of this patent, at R. 254), "having one end attached to the upper portion of the posts 4 above the roof, and the other end attached to the upper portion of the timber, 8, with a turn buckle in between said ends" (this turn buckle is marked 13 in Fig. 1 of this patent) "*to provide means for adjustment to keep the roof always at the desired elevation.*" (Italics ours.)

The defendants' housing is illustrated by two drawings, the most correct and accurate of which was put in evidence by defendants' counsel in connection with the cross-examination of plaintiff's witness, Keene. That drawing (the

original exhibit was in the form of a blue print) is marked "Defendants' Exhibit C" and is found at R. 142; it was put in evidence at R. 76 and is referred to by plaintiff's witness, Keene, at R. 75, as follows:

> "The next picture, the blue print attached to Heintz's affidavit, shows the construction of the housing" (defendants' housing) "*as I saw it at Springdale Park;* it must have been taken on the turn because the tie is kind of slanting, *but it is a correct view of the housing.*" (Italics ours.)

The other sketch or drawing of defendants' housing is the one marked "Plaintiff's Exhibit 5", found at R. 117, which was referred to by the witness, Keene, and which was marked by him, to suit his own purposes or those of plaintiff, in one part thereof with the words "truss rod".

When we examine the true and more correct drawing of defendants' housing found at R. 142, it will be noted that there is there illustrated in cross-section the two vertical posts and a roof, a floor or bed on which the two rails for the car are laid, and the third or central rail which acts as a conduit for the electric current. For the rest, it simply shows an ordinary projection or roof, supported by a horizontal wooden beam, the latter being braced by two wooden braces, one of which is fastened by nails at its upper end to the inner part of the said horizintal beam and at its lower end to the longer vertical beam, and the other of which is nailed at its upper end to the extreme outer end of the said horizontal beam and at its lower end to the said longer vertical beam.

In defendants' device there is not present any "*adjustable stay rods*", or any *adjustable stay rod*, or any "*screw threaded adjustable stay rods*", and there is not present in defendants' housing any turnbuckle between or con-

necting any truss rods or stay rods; and defendants' device is not provided with any means of adjusting any truss rods or stay rods, so as to prevent the roof from sagging and to keep the roof always at the desired elevation. In defendants' housing the roof or projection over the rails is constructed as any such projecting roof or wooden awning over a door has been constructed from time immemorial, i. e., by nailing or otherwise securely fastening, to the beam or projection which supports the cover or boards for the roof, a board and then nailing, or otherwise securely fastening, the lower end of such last named board or support to the wall of the house or to a beam or projection connected with the latter.

Nevertheless, because of the peculiar wording and rather loose language used in Claim 1 of said Smith patent, which claim is found at R. 256 and 256-a, petitioner contends that defendants' said housing infringes that claim of the said Smith patent No. 1,507,440. In the Courts below, in the case at bar, petitioner contended that defendants' housing infringed all three of the claims of the said Smith patent. Claim 1 of said Smith patent is in the following words:

> "1. In a housing for covering tracks and cars having laterally extending arm operated upon said track, the combination of posts set in the ground at the sides of said track, timbers attached to said posts to form a frame, and boards attached to said timbers and posts to form a continuous enclosure above said track, and having a continuous opening in one side of said housing adapted to permit extension of the laterally extending arm therethrough, and truss rods attached to the closed side of the housing adapted to support the side of said housing above the said continuous opening."

In. Claim 2 of said patent the "*adjustable stay rods*" illustrated and described in the Smith patent are specifically made elements of the claim; and in Claim 3 of the said Smith patent "*screw-threaded adjustable stay rods*" are made essential elements of the claim.

So far as the housing or casing for a lure conveyer is concerned, such housing or casing having a continuous opening therein through which the lure-carrying arm passes and travels, the said housing also enclosing the car and its rails, such a structure is shown in the Smith patent of 1912, found at R. 276; and, as we have already seen, a housing having all of these characteristics, used for dog racing purposes, and differing only from the housing of this Smith patent of 1924, in that it had *no screw-threaded adjustable stay rods for adjusting and supporting the roof*, is illustrated and described in the Smith patent 1,379,224, of 1921, found at R. 187, and such a housing is actually *claimed* as an essential part of the device claimed by Claims 1, 2 and 3 of that patent of 1921. Moreover, it is a matter of common knowledge, in respect to electrically operated cars for conveying passengers, that the third rail and mechanism for making an electric contact, whether located under the ground or at one side of the track, has been for a great number of years provided with a housing and a slot in the housing, through which slot the arm or connection between the car and electric devices for conducting and transmitting electricity are passed, all such housings being provided, either on the side thereof, or on the upper part thereof, with a continuous slot or opening. Such a construction, for example, is found in the Bertram patent, of 1903, found at R. 343. And so far as concerns the stay rods or truss rods, threaded at their inner ends and connected together by a turnbuckle, to support the roof and tighten it in case of sagging, such devices are very

old and matters, we believe, of common knowledge. At any rate, they are shown as used for just such purposes in connection with roofs in the patent to Buckley, of 1885, at R. 347; in the patent to Harvey, of 1889, at R. 350; in the patent to Dunbar, of 1889, at R. 358; and in the patent to Delahunt, of 1896, at R. 365.

We contend, therefore: (a) That Claim 1 of Smith patent 1,507,440 (the only claim of this patent *now* relied upon by the petitioner, see petitioner's brief "Point G", page 51) is destitute of patentable novelty and invention; and (b) that said claim is not infringed by defendants' housing.

Clearly, the defendants' housing does not infringe any of the three claims of the said Smith patent, and the Courts below so held, in addition to holding the claims of this patent void. But it was not until after this case reached this Court that petitioner's counsel abandoned all contention as to the infringement of Claims 2 and 3 of said patent.

A claim is *absolutely void* when it claims more than belongs to the invention as the invention is illustrated and described in the patent.

> Robinson on Patents, Vol. 2, Sec. 537, page 154;
> Milligan v. Lalance & Grosjean Mfg. Co., 21 Fed., 570.

When a claim is obscure, or capable of different interpretations, the drawings and specification of the patent must be considered as exponents of the claim and as determining the meaning and application of the words used in the claim.

> Robinson on Patents, Vol. 2, Sec. 742, page 495;
> Matthews v. Iron Clad Mfg. Co., 124 U. S., 347, 351;
> Railway Reg. Mfg. Co. v. Third Ave. Ry. Co., 33 Fed., 31.

The decision of this Court in Fay v. Cordesman, 109 U. S., 408-421, illustrates and supports our contention in this case: that, while Claim 1 of Smith patent No. 1,507,440 (the only claim of that patent *now* relied upon by petitioner) does not expressly state—as do Claims 2 and 3—that the "*stay rods*" (marked "12" in the patent) are "*adjustable*", or "*screw threaded adjustable stay rods*"—but says "*truss rods attached to the closed side of the housing adapted to support the side of said housing above the said continuous opening*"; nevertheless, in harmony with the *only* construction illustrated in the drawings and described in the specification of the patent, and to "*provide means for adjustment to keep the roof always at the desired elevation*", as called for in the patent (see R. 256), *adjustable* stay rods, *threaded* and *provided with a turnbuckle*, must be read into Claim 1, or else that claim is void as not properly *claiming* the particular and only structure *disclosed* in the patent. In such circumstances, it matters not that Claim 1, thus construed, becomes substantially the same as other claims in the patent; unless thus construed, it is void as being broader than the *only* structure disclosed and described in the patent.

In Fay v. Cordesman, *supra*, the third patent sued on was for improvements in band saw machines. The patent contained seven claims, but plaintiff only relied upon Claims 1, 2, 3 and 4 (see 109 U. S., at page 417).

After quoting the specification of the patent and all the claims of the patent except Claim 7, this Court, reading into Claims 1 and 2 (see 109 U. S., at page 419) characteristics of the invention as disclosed in the patent, *but not found in defendant's device*, found that Claims 1 and 2 had not been infringed; it also found Claims 3 and 4 not infringed (see 109 U. S., at page 420). But the pertinent part of the opinion, applicable to the case at bar and to

the precise question with which we are dealing here is this: In that case, as in the case at bar with respect to this Smith patent No. 1,507,440, the plaintiff sought to ignore claims of the patent which, in terms, limited the claims to a combination of elements or conditions described and illustrated in the patent but not present in defendant's device (Claims 5 and 6 in *that* case; Claims 2 and 3 in the instant case), and to rely upon claims in which such elements or conditions were not, in terms, specified.

Dealing with this particular question, as applied to Claims 2 and 3 of the patent before the Court in that case, in which claims a certain spring "O" was not specified, finding no infringement of Claims 2 and 3, and considering, in the interpretation of Claims 2 and 3, the Claims 5 and 6 of the patent *but which Claims 5 and 6 the plaintiff in that case wished to ignore,* this Court holds, in that case, at page 420 of 109 U. S., as follows:

> "The spring O gives an elastic character to the tension. The effect of the arrangement or combination is to give an elastic vertical adjustment and also a horizontal adjustment. The whole object of the saddle with the lug l and the extension k is to adjust the arbor-bearing up and down and sidewise and at the same time give an elastic tension to the saw. The spring carries the weight of the saddle. There can be no operative arrangement of the saddle with the arbor-bearing which does not include the lug l, the screw N, the extension k, the screw M, the nut T, and the spring O. These are all elements in the arrangement or combination covered by Claim 3. The spring is essential in the patent, as a part of claim 2. The defendants have a rigid saddle, and no spring. *The fact that the spring is an element in claims 5 and 6 does not prevent its being an element in claim 3.*" (Italics ours.)

Paraphrasing what this Court says above and applying it to the Smith patent No. 1,507,440 we say: There can be no operative arrangement of the housing structure illustrated and described in said Smith patent *"to provide means for adjustment to keep the roof always at the desired elevation"* (R. 256) which does not include the means for accomplishing that object, which means consist of *the "adjustable stay rods" 18, screw-threaded at their inner ends, the said ends being connected by a turn buckle, all substantially as described and illustrated in the patent and specified elements of Claims 2 and 3.* The fact that such "adjustable stay rods", to accomplish the above stated purpose, are elements specified in Claims 2 and 3 of said Smith patent (claims not *now* relied upon by petitioner) does not prevent them from being essential elements or conditions of Claim 1.

Unless Claim 1 of said Smith patent be thus construed, it is void, not being for the thing *disclosed* in the patent.

And, thus construed, defendants' device, illustrated at R. 142 and also at R. 117, does not infringe said Claim 1.

On this question of non-infringement of Smith patent 1,507,440 and the limited construction that must be given to Claim 1 of that patent, when read in the light of the structure illustrated in the drawings and described in the specification of the patent, see this Court in Computing Scale Co. v. Automatic Scale Co., 204 U. S., at pages 621 and 622, and also the recent opinion (rendered Dec. 8, 1930) of this Court in Lektophone Corp. v. The Rola Co., being Case No. 19, October Term, 1930.

THE PRIOR DECISIONS RELATING TO THE SMITH PATENTS IN THIS SUIT.

The first suit relating to these Smith patents was that of Smith v. American Electric Rabbit Racing Assn. et al., and the only real "*opinion*" in that case (an utterly unsound one) is that of the District Court for the Eastern District of Louisiana, by Burns, J., reported in 21 Fed. (2nd), 366, affirmed, as to its "*conclusions*", by the C. C. A. for the Fifth Circuit in 26 Fed. (2nd), 1016.

As we devote the last chapter of this brief to said decisions in that Louisiana case, we only desire to say here, as to that case, the following things: It appears from the record in that case, brought up by us to this Court on the petition of Heintz and American Electric Rabbit Racing Assn. for certiorari (No. 449, October Term, 1928), which petition was denied (see 278 U. S., 626, and this brief at page 2 *supra*), and also, as we believe, it sufficiently appears from the said opinion of the District Court in that case, in 21 Fed. (2nd), 366: that the validity of the three Smith patents before the Court in that case was not contested, the then counsel for defendants in that case announcing, at the opening of the case in the District Court, that he would not dispute the validity of any of said three Smith patents.

So that the only questions tried and determined by the District Court in that case related to the infringement of said patents by the defendants' devices before the Court in that case.

It also appears, from the opinion of the District Court in that case, in describing the defendants' devices before it in that case, as also appears from petitioner's brief in the instant case, that the defendants' devices in that case were, in construction, substantially identical with defendants'

devices before the Courts in the Sixth Circuit and, therefore, before this Court in the case at bar.

And yet, *mirabile dictu*, in view of said situation, the following pertinent and interesting facts appear in respect to the Smith housing patent No. 1,507,440: As we have said and as the opinion of the District Court in said New Orleans case shows (see 21 Fed., 2nd Series, Division 7, at pages 372-374), that Court held that the defendants' housing in that case, which, in construction, was substantially identical with defendants' housing in the case at bar, infringed Claims 1, 2 and 3 (all the claims) of said Smith patent 1,507,440; and yet, in the case at bar, petitioner *now* contends that respondents' housing only infringes Claim 1 of said Smith patent (see petitioner's brief at page 51).

This, we submit, is virtually an admission that the Courts in the 5th Circuit were at least in error in so far as they found that defendants' housing in that case—which was virtually the identical housing of respondents here—infringed Claims 2 and 3 of said Smith patent No. 1,507,440.

The next reported opinion in order of date, though not in order of publication, in respect to the three Smith patents before this Court in the case at bar is the opinion of Judge Hickenlooper, then District Judge, now Circuit Judge, in the case now before this Court for review. That opinion, dated June 23, 1928, is found at R. 89; it is also reported in 39 Fed. (2nd), 92. That opinion speaks for itself and resulted in the decree dismissing the bill as to all of these three Smith patents, said decree being found at R. 100, and finds that defendants' devices before the Court in this case did not infringe Claims 1 and 2 (the only claims in issue) of Smith patent 1,379,224; that said devices did not infringe the Smith starting cage patent No. 1,507,439; and that the Smith housing patent 1,507,440 is

lacking in patentable novelty and invention, but, if valid, was not infringed by defendants' housing, and dismisses the bill. It will be noted from that opinion of Judge Hickenlooper (see R. 95) that he had before him and considered the opinion of the District Court in the said New Orleans case in 21 Fed. (2nd), 366, and the action of the C. C. A. for the 5th Circuit in affirming the decree of the District Court in that case (26 Fed., 2nd Series, 1016), but felt constrained not to follow those decisions. Afterwards, and on appeal from the said decree and opinion entered and delivered in the case at bar by the District Court, this suit against the Springdale Amusement Park, Ltd., et al., was argued before and submitted to the C. C. A. for the 6th Circuit, which Court, by its unanimous opinion, by Moorman, C. J., reported in 40 Fed. (2nd), 173, which opinion is also found here at R. 368, affirmed the decree of the District Court. That opinion of the C. C. A. for the 6th Circuit speaks for itself, and while it affirms the decree of the Court below in dismissing the bill, it differs only from the opinion of Judge Hickenlooper in that it finds the Smith starting cage patent, No. 1,507,439, not only invalid, but, if valid, not infringed.

The only other reported decision in respect to any of these Smith patents is one rendered by the C. C. A. for the 10th Circuit in the case of Magic City Kennel Club, Inc., et al. v. Smith, which opinion, rendered Jan. 21, 1930, is reported in 38 Fed. (2nd), 170. That opinion of the C. C. A. for the 10th Circuit was rendered after Judge Hickenlooper had rendered his opinion in the case at bar but about three months before the C. C. A. for the 6th Circuit rendered its opinion in the case at bar.

It appears from the opinion of the C. C. A. for the 10th Circuit in the said Magic City Kennel Club case that the Smith patents before the Court in that case were Smith pat-

ent 1,379,224 and the Smith housing patent 1,507,440, both of which Smith patents are before the Court in the case at bar; but the Smith starting cage patent, No. 1,507,439 (another Smith patent before this Court in the case at bar) was not before the Court in that case in 10th Circuit. The third Smith patent, No. 1,630,812, which was before the C. C. A. for the 10th Circuit in the said Magic City Kennel Club case, was one of the many Smith patents originally declared upon in petitioner's bill in the case at bar (see 10th clause of bill, at R. 7), but one of the Smith patents which the plaintiff-petitioner in this case, by her counsel, declared she would not rely upon at the hearing (see R. 60). In said opinion of the C. C. A. for the 10th Circuit that Court considered the opinion of the District Court in the New Orleans case (21 Fed., 2nd Series, 366) and the action of the C. C. A. for the 5th Circuit in affirming the decree of the District Court in that case, in 26 Fed. (2nd), 1016, but refused to follow them (see 38 Fed., 2nd Series, at page 171).

The said Magic City Kennel Club case was taken before this Court by certiorari, and, as we are informed at this writing, was argued and submitted to this Court on, to-wit, the 27th of January, 1931. It appears from the opinion of the C. C. A. for the 10th Circuit in the Magic City Kennel Club case, 38 Fed. (2nd), 173, that the defendants' devices in that case were very similar to defendants' devices in the New Orleans case and in the case at bar and that that Court held that such devices did not infringe either the Smith patent 1,379,224 or the Smith housing patent 1,507,440. As to the said Smith housing patent, No. 1,507,440, the C. C. A. for the 10th Circuit, in 38 Fed. (2nd), 173, while it points out that the validity of that Smith patent was not specifically in issue in that case, nevertheless states that that Court would not be war-

ranted in affirming a decree predicated on a device clearly not patentable. It would seem clear from that opinion that that Court held that that Smith housing patent No. 1,507,440 was void for lack of patentable novelty and invention, and also that that patent was not infringed.

THE OPINION OF THE DISTRICT COURT IN SMITH V. AMERICAN ELECTRIC RABBIT RACING ASSN. IN 21 FED. (2D), 366.

This case would not be before this Court but for the fact that the *reasoned opinion* of the United States Circuit Court of Appeals for the Sixth Circuit, rendered in this case on April 15, 1930 (reported in 40 Fed., 2nd Series, 173), is in clear conflict with the *mere conclusions* reached by the United States Circuit Court of Appeals for the Fifth Circuit in a case under the same patents and in which the defendants' devices were substantially identical with defendants' devices in the case at bar—the case of American Elec. Rabbit Racing Assn. et al., Appellants (Defendants), v. Smith etc., reported in 26 Fed., 2nd Series, at page 1016.

We mentioned above the *"reasoned" opinion* of the C. C. A. for the Sixth Circuit in contrast with the announced *"mere conclusions"* of the C. C. A. for the Fifth Circuit, because, as appears from what the Appellate Courts did in said cases, the C. C. A. for the Sixth Circuit (see 40 Fed., 2nd Series, 173-176) did, in fact, deliver an opinion which not only sets forth the essential facts in the case before it, but also quite fully states *the reasons for giving the judgment which it pronounced upon the case,* thus rendering an *opinion* within the true, technical, legal definition of an *"opinion"* (see Baldwin's Century Edition of Bouvier's Law Dictionary, at page 876).

On the other hand (see 26 Fed., 2nd Series, at page 1016) what the C. C. A. for the Fifth Circuit did, in that case before it, was merely this: to state the numbers of the three Smith patents before the Court in that case; to state that the opinion of the District Court is reported in 21 Fed. (2nd), 366; and then, without adopting the opinion of the District Court as it own, merely to state: "We agree with the *conclusions*" (the emphasis is ours) "of the District Court. Affirmed."

This, according to Bouvier's Law Dictionary, technically and accurately speaking, in legal practice, is not an opinion, as it is not "*the statement of reasons delivered by a judge or court for giving the judgment which is pronounced upon a case*".

And, in referring to what said C. C. A. for the Fifth Circuit did in that case, as reported in 26 Fed. (2nd), at page 1016, the C. C. A. for the Tenth Circuit, in its opinion, in Magic City Kennel Club et al. v. Smith (see 38 Fed., 2nd Series, at page 171), after referring to the opinion of the District Court, by Burns, J., in Smith v. American Rabbit Racing Assn. (21 Fed., 2nd Series, 366), says: "*The Court of Appeals of the Fifth Circuit affirmed the decree, without opinion.* Id., 26 Fed. (2d) 1016".

Therefore, so far as relates to that suit in the Fifth Circuit, by reason of which and the opinion of the C. C. A. for the Sixth Circuit *supra* the instant case is before this Court, the only *opinion*, giving reasons for the decree (an interlocutory decree) entered in that case in Fifth Circuit, is the *opinion* of District Judge Burns, reported in 21 Fed. (2nd), 366. In that opinion (21 Fed., 2nd, 366), the District Judge, in discussing the identical three Smith patents before the Courts of the Sixth Circuit and before this Court in the case at bar, recognizes the following facts

which are common to the case before him and the case at bar:

(1) That, as to the Smith patent No. 1,379,224, for *"Dog Racing Amusement"*, found here at R. 186-192c and with respect to which, in the case at bar, the plaintiff-petitioner elected to stand only on Claims 1 and 2 thereof (see opinion of Judge Hickenlooper, R. 89, and decree, R. 100), the following specified conditions and elements are conditions and elements forming part of the "machine" illustrated in the drawings of said patent, described in the specification of said patent and expressly and clearly *specified* in Claims 1 and 2 of said patent:

In Claim 1, that the combination of elements therein specified shall include (a) "a casing extending around the *outer* side of the race course"; and (b) "a wheel rotatably mounted on and supporting the arm at the projecting end thereof."

In Claim 2, that the combination of elements therein specified shall include "a horizontal extending arm *hinged* to said car" (the conveyor car specified in the claim); and (b) "a wheel rotatably mounted near the end of said arm and resting upon the ground."

(2) That in the defendants' structure in that case (as is also true of defendants' device in the case at bar, see R. 75 and 77 and also reference at R. 77 to the Creveling patent, said Creveling patent being found at R. 147, and photograph of defendants' device found at R. 140), the casing or housing extends around the *inner* side of the race course and there is not present, in defendants' device, the element *"a wheel rotatably mounted on and supporting the arm at the projecting end thereof"*, or any wheel at all (an express condition and positive element of Claim 1).

(3) That in the defendants' device in that case (as is

also true of defendants' device in the case at bar) the arm which carries the lure is not "*hinged*" to the car, but, as petitioner's witness, Keene, states, at R. 75 and R. 77, "*there is no wheel at the end of the lure-carrying arm*". * * * "*The arm is supported by the disks; it is rigidly supported*". In defendants' device (see Keene, R. 77) the arm is fastened to the car in the manner illustrated by the Creveling patent, found at R. 147-148, and as also illustrated by the photographs at R. 140 and 141.

(4) Although Judge Burns found the facts, as to the construction of defendants' device, to be what we have stated above, nevertheless, on a strange application of the doctrine of mechanical equivalents, he found, in that case, that defendants' device infringed the said Claims 1 and 2 of said Smith patent No. 1,379,224.

When the facts in this case and the said case in the Fifth Circuit are kept in mind, it will be seen that Judge Burns, in and by his opinion (21 Fed., 2nd, 366-372), invoking the decision of this Court in Winans v. Denmead, 15 Howard, 330 (which case, in its facts, is radically different from the facts in the case before Judge Burns and from the facts in the case at bar), holds:

(1) That although Claim 1 of Smith patent No. 1,379,224, *in harmony with the only construction illustrated and described in that patent*, and because of the fact that the conveyor car, at the end of its course around the track (see Fig. 1 of this Smith patent, R. 186, and specification of that patent, first paragraph, at R. 192a) is diverted onto the switch and track to the den or enclosure where the car and the lure are thus concealed from view of the hounds after the race, which den or enclosure (see top of Fig. 1 of patent, at R. 186) is located entirely *outside* the race course, specifies that the casing shall extend "around the *outer* side of the race course"—that nevertheless that

qualification and express limitation in Claim 1 ("a casing extending around the *outer* side of the race course") is of no consequence and can be ignored.

(2) That Judge Burns, in his said opinion, also holds, as to Claim 1 of this Smith patent, that the combination of elements specified in that claim is present in defendants' device, although the element of "*a wheel rotatably mounted on and supporting the arm on the projecting end thereof*" (a positive element, with a definite function ascribed to it both in the *specification* and in the *claim*) was entirely absent in defendants' device before him in that case, as his opinion shows.

(3) As to Claim 2 of this Smith patent No. 1,379,224, although that claim, in harmony with the drawings and specification of that patent (see particularly Figs. 2 and 3, R. 187 and 188, and the description in the specification of that patent, R. 191) and in order to enable the arm which carries the lure to be capable of vertical movement and to keep the wheel, at its outer end, always in contact with the ground while being thus able to adjust the arm to any unevenness on the course, expressly provides that that arm shall be "*hinged*" to the car, and that said "*hinged*" arm shall be provided with "*a wheel rotatably mounted near the end of said arm and resting upon the ground*"; nevertheless, Judge Burns, in his said opinion, ignores entirely (or treats as of no consequence) these positive conditions and elements, particularly specified in Claim 2 and described and illustrated in the specification and drawings of the patent, and holds: that defendants' device before him in that case, in which the arm at its inner end was rigidly held in place on the car, was *not hinged*, had *no provision to allow for vertical motion* and was provided *with no wheel at all*, much less "*a wheel rotatably mounted*

near the end of said" (hinged) "arm", embodied the invention *claimed* by Claim 2 of that patent.

Ignoring, or treating as of no consequence, the said conditions and positive elements present in said Claims 1 and 2 and Smith's definition and description of what he *disclosed* in his drawings and specification and particularly *claimed* as his invention, because Judge Burns seemed to think that defendants' device in that case, made under the Creveling patent (the patent found here at R. 147), accomplished the purpose or result of concealing the car in the housing while travelling around the course, and that the car carried an arm projecting horizontally over the course and carrying a lure at its outer end, *ergo* it necessarily followed, on his interpretation of this Court's decision in Winans v. Denmead, that, regardless of the terms of said claims, regardless of the fact that a positive element of each of said claims (the said wheel at the outer end of the arm) was entirely absent in defendants' device, and that, in defendants' device, the casing or housing extends around the *inner* side of the race course (see Figs. 1 and 2 of Creveling patent, at R. 147) instead of the *outer* side, as illustrated and described in said Smith patent and specified in Claim 1 of this Smith patent, and regardless of the fact that the "*hinged*" arm illustrated and described in said Smith patent and specified in Claim 2 of said Smith patent is entirely absent in defendants' device before the Court in that case (all of which things are true in the case at bar)—nevertheless defendants' device in that case infringed said Claims 1 and 2 of said Smith patent.

Such a conclusion, in view of the express terms and limitations as to *number* of elements and *conditions* of elements or structures found in said claims, involved a *non sequitur*, even if it were true (which it is not in point of fact) that in the said case in the Fifth Circuit, before

Judge Burns, defendants' device performed the same function or functions as the function or functions performed by the machine or device of said Smith patent, and which machine, after having been illustrated and described in the drawings and specification of said Smith patent No. 1,379,224 (in order to disclose that alleged invention and *"the principle thereof"*), was then distinctly *claimed* by Smith, according to the intent and purpose of Sec. 4888 R. S. U. S., by said Claims 1 and 2. For it is obvious that *the particular means* (the particular *conditions, number* and *arrangement* of *elements* specified in said claims of said Smith patent) were not present in defendants' machine before the Court in that case; and it has been repeatedly decided by this Court, as recently reaffirmed in I. T. S. Co. v. Essex Co., 272 U. S., at page 444, that when, in order to obtain a patent and in accordance with Sec. 4888 R. S. U. S., the patentee has described his machine or device and explained *"the principle thereof"* in his specification and then particularly pointed out and distinctly claimed (as he must do under that Statute) the particular improvement or combination *"which he claims as his invention"* (all of which is true as to this Smith patent and the claims thereof), it is utterly immaterial, even if it be true in point of fact, that defendants' device or machine functions in the same manner as that of plaintiff's patent, when the claims of the plaintiff's patent (as was true in the said case before Judge Burns and is true in the case at bar) are restricted, as to numbers of elements, or by limiting clauses, and there is not present in defendants' device or structure, either in number of elements, or in conditions and restrictions specified in the claims, *the means*—the particular thing or things *claimed* by the *claims* of plaintiff's patent.

And it is still true, as it has always been true, under our patent system, and as this Court declared in Leeds & Catlin v. Victor etc. Co., 213 U. S., 301, that the thing *patented* is the thing *claimed*, and nothing else.

Judge Burns, in his said opinion in the said case in the 5th Circuit, not only erred in applying the law to the facts in the case before him, even as those facts are stated by him in his opinion, but he also erred in point of fact, because the principle of operation of and the functions performed by defendants' device in that case (as is also true of defendants' device in the case at bar) are not identical with the principle of operation of and the functions performed by the particular machine disclosed, described and claimed in the said Smith patent No. 1,379,224.

In the first place, the principle of operation of the machine illustrated and described in this Smith patent No. 1,379,224 is one in which the housing or casing which encloses the car is located, as described in the specification of that patent and particularly illustrated in Fig. 1 of that patent, on the *outer* side of the elliptical or oblong race course illustrated in the patent, with these results: that the hounds, in following the lure, will take the longer course in the track or race course, as illustrated in Fig. 1 of that Smith patent, and that, as the car travels on rails, at the curves, as is true of all curves on railways, the outer rail is slightly higher than the inner rail, with the result that the car, as it rounds the curves, is slightly tilted, the effect of which, if the arm were rigidly fastened to the car at its inner end and not *hinged*, as it is illustrated, described and claimed, would be that the arm might not give sufficiently at its outer end and be snapped off or broken. The same disaster might also happen, in the device of said Smith patent, due to any unevenness on the course itself.

Another principle of construction and operation peculiar to the device of said Smith patent is this: In that structure, as contemplated, disclosed and described in that Smith patent No. 1,379,224, the arm, which is *hinged* to the car, so as to be capable of more or less upward or downward movement in a vertical direction, *and which carries a wheel at its outer end*, so as to prevent the outer end of the arm which carries the lure from striking the ground, and which wheel also *performs the function of supporting the arm at its outer end*, has no means of being retracted or drawn into the casing or housing, but, in the construction illustrated and described in the said Smith patent, at the end of the course, as described in the specification and illustrated at the top right-hand side in Fig. 1 of said Smith patent, after the car, which carries the *hinged* arm *provided with a wheel at its outer end*, has made the complete course, the car with its projecting arm, lure and wheel are all shunted onto a switch or track extending completely outside of the race course from the outer side of the race course, and then a door is closed. The arm and lure of this Smith patent do not "*disappear into the casing*", as stated at the foot of page 4 of petitioner's brief. These things characterize the principle of construction and operation of the device of this Smith patent. In defendants' device before Judge Burns in that case (as is true of defendants' device in the case at bar) however, which device, as his opinion states, is constructed in accordance with the said Creveling patent, found at R. 147 and 148, the housing is located on the *inner* side of the track or race course, and the car, at the end of its course, is not taken out of the housing or casing and not taken outside of the race course itself, but remains on the track, in the housing. In defendants' device, the arm, which carries the lure at its outer end, is *rigidly fastened*, at its inner end, to a disk

located on the frame of the car, as particularly illustrated in Figs. 3 and 5 of the said Creveling patent at R. 148, and that arm is *not hinged* to the car and is incapable of any up and down or vertical movement independently of the movement of the car, and that arm is not provided with any wheel at all and therefore is not provided with any wheel at its outer end resting upon the ground and performing the function of supporting the arm at it's outer end. In defendants' device, as the track, car and housing are located at the *inner* side of the race course, not only do the hounds in quest of the lure take the inner or shorter course around the curves, but, at the curves, the outer rail of the track being slightly elevated above the inner rail (a matter of common knowledge) the lure-carrying arm, *rigidly fastened* at its inner end to the car, takes the same tilt as the car—in a direction away from the ground, thus tending to keep the outer end of the arm from contact with the ground. As to this, also see drawing at R. 142 and the testimony of plaintiff's witness, Keene, relating thereto at foot of R. 75.

In that device of defendants, made in these respects in accordance with the said Creveling patent, when the race is started the arm is pulled out manually against the resistance of the spring 6, so that its outer end extends over the race course, as illustrated in Figs. 2 and 3 of the said Creveling patent at R. 147 and 148, and then locked in that position, at right angles to the longitude of the frame of the car. At the end of the course that arm is automatically tripped by the mechanism illustrated in the drawing of the Creveling patent at page 148 of the record, and the spring 6, illustrated in Fig. 3 of said Creveling patent, then pulls the arm with its lure at its outer end back into the casing, thus concealing the arm and the lure in the housing and from the hounds.

Therefore, in the sense that in defendants' device in that case before Judge Burns (as is also true of defendants' device in the case at bar) the casing or housing, the car and the tracks for the car are all located on the *inner* side of the race course; and in the sense that the car with its lure-carrying arm, etc., is not taken out of the race course at all; and in the sense that the lure-carrying arm is not *hinged* to the car at the inner end of the arm, but is *rigidly* held in place on the car at the inner end of the arm; and in the sense that the lure-carrying arm is not provided at its outer end or anywhere with any wheel at all—much less with a wheel for supporting the outer end of the arm and preventing the outer end of the arm from coming in contact with the ground; and in the sense that in defendants' device the lure-carrying arm is incapable of any upward and downward or vertical movement—in all these senses not only *is the principle of construction and operation of defendants' device different from that disclosed, illustrated, described and claimed in the Smith patent,* but defendants' device *functions* in a different manner from that of the said Smith patent No. 1,379,224.

Therefore, both in fact and in law, in the respects above alluded to, Judge Burns' opinion is pregnant with error. In the case before Judge Burns, as is also true in this case from the Sixth Circuit which is now before this Court on certiorari, not only is the principle of operation of defendants' device different from the principle of operation of the device of the said Smith patent, and not only does defendants' device function in a different manner from that disclosed, described, illustrated and claimed in the said Smith patent No. 1,379,224, but also, in number of elements and in limitations as to construction and arrangement of elements, the defendants' device is not the device

claimed (patented) by Claims 1 and 2 (the claims in issue in the case at bar) of said Smith patent No. 1,379,224.

A false premise, adopted by Judge Burns in reaching the conclusion that the defendants' device in that case before him infringed said claims of this Smith patent, is this: Having reached his own conclusion *as to what he conceived Smith had invented,* he then proceeds to recast the claims of the patent, or to so construe them, as to make the claims cover, not the combination and arrangement of elements as *disclosed* by the patent and as *particularly claimed* by the alleged inventor, but so as to embrace what he conceived to be the step in advance in the art which Smith had made. In his opinion, with reference to this Smith patent No. 1,379,224 and as to what he concluded Smith had invented, the Judge states, at page 372, first column, of 21 Fed. (2d):

> "Here Smith successfully combined known elements. The substantial advance he made in the art resulted principally from his adaptation of a horizontally inclined lure-supporting arm projecting out of a longitudinally continuous opening in the conveyor housing" * * *.

Granting, for argument's sake only, that the foregoing statement of the Judge correctly states an advance over the prior art and that Smith invented such a thing, the answer is: *that is not the thing which Smith, in pursuance of the requirements of the law as expressed in Sec. 4888, R. S. U. S., particularly pointed out and distinctly claimed as the particular combination of elements constituting "his invention"; it is not the thing patented, i. e., claimed, by Smith in this patent.*

Moreover, as this Court has repeatedly held, it is the

province of the inventor to make his own claim, as it is his province to restrict it; what the inventor may have invented, but not claimed, he abandons; and the Courts are powerless, under the guise of construing claims of a patent, to accomplish what can only be lawfully done, if done at all, under the reissue statute (Sec. 4916, R. S. U. S.); and it is never permissible for the Court to read out of a claim, by construction, an element, or a condition, of a device or structure, which element or condition the patentee, by his specification and claims, has defined or described as part of, or as essential to, the invention which he *claims* in his patent.

An early and leading decision of this Court, rendered as far back as 1861, cited and the doctrine of which is reaffirmed by this Court in McClain v. Ortmayer, 141 U. S., at page 425, as well as in many other later decisions of this Court, and which serves admirably to illustrate the fallacies, both in the reasoning and in the conclusions of the said opinion of Burns, J., is that in Vance v. Campbell, 1 Black (66 U. S.) 427-429. In that case the patent in suit was one for certain improvements in cooking stoves. This Court there points out that the patentee, by the specification of his patent, illustrated, described and claimed his device as one which, due to its construction, would do away with certain irregularities that would otherwise exist in the distribution of the heat around the oven of a stove. To accomplish the desired result, his patent described that he placed a plate A in front of the cold air chamber, so as to form a flue in front, and otherwise arranged his device as claimed in his patent. As this Court points out (see pages 428 and 429 of 1 Black), the defendant's stove had no plate A in front of the cold-air chamber, and hence one of the elements of plaintiff's combination was not

present in defendant's device. And then this Court says, in that case:

> "The plaintiff, however, sought to get rid of that objection, by proving that that part of his contrivance and claim was immaterial and useless" (just as in the case at bar and in the said case in the Fifth Circuit the plaintiff contends that the wheel specified in the claim of the Smith patent—a thing not present in defendants' device—is not essential, as Judge Burns also found) "and that the diffusion of the heated air around all sides of the oven would be effectual without it."

Then, after pointing out that plaintiff relied on his patent for the measure of his right, as he had to do under the law, and that the defendant had denied the infringement as charged and in finding no infringement and reversing the judgment below, this Court says in that case, at pages 429 and 430 of 1 Black (66 U. S.), what is peculiarly applicable here, as refuting the opinion of Judge Burns in that case in the Fifth Circuit as well as the specious argument of petitioner's counsel in the case at bar, as follows:

> "Besides the above view, it is most apparent, from an examination of the specification, that the patentee not only described, but claimed the front flue formed by the plate A, fig. 2, as a material and important part of the arrangement for distributing equally the hot air on the several sides of the oven. To prevent irregularities, referred to and particularly described, he observes: 'I place the plate A, as in fig. 2, so that it will form a flue in front of the cold chamber, whose mouth (as it is called) is at the same distance from the flue above the oven that the lower end of the pipe i is above the flue below the oven; and these

flues being at all times unobstructed, their action is uniform, and the heat is equally distributed, under all circumstances, on the several sides of the oven.' The patentee might as well have undertaken to prove any other part of the combination immaterial and useless, as the part above, and its uses so particularly described. Indeed, according to the doctrine contended for, a patent would furnish no distinct evidence of the thing invented, as that would depend upon what part of the specification and claim the jury might think material or essential."

The case of Vance v. Campbell was a case at law, as is true of many of the early patent cases which came before this Court, but, of course, the same principles apply to a suit in equity. Neither in a case at law, before a jury, nor in a case in equity, tried before a Judge alone, is it permissible for the jury, or the Judge, to determine that a particular element or part of a device specified as an element of the device claimed in the patent is not material or essential. This is precisely the error which Judge Burns fell into in the said case in the Fifth Circuit, when he held that the *wheel* at the outer end of the lure-carrying arm, the *hinged* arm, etc., specified elements and conditions in claims 1 and 2 of this Smith patent, were not material or essential parts of the particular alleged invention the subject matter of said claims.

The said decision of this Court in the said case of Vance v. Campbell, 1 Black (66 U. S.) 427, has been repeatedly followed and expressly cited with approval by this Court, in numerous decisions, in support of the proposition: *that it is not permissible to enlarge a claim by taking out of it, or reading out of it by construction, any of the elements specified therein; that a machine or device which is de-*

scribed and claimed in a patent as consisting of a number of elements co-ordinated and arranged to accomplish a certain purpose or result is an entirety; that every element specified in the claim is conclusively presumed to be essential to the invention claimed; and that another machine or device, which is lacking in any element specified in the claim, is not the machine or device of such patent and does not infringe the same.

Some of the decisions of this Court, to the effect just stated, and which expressly follow and cite the case of Vance v. Campbell, *supra*, are the following:

Gill v. Wells, 22 Wall. (89 U. S.), at pages 24-25;
Gage v. Herring, 107 U. S., at page 644;
Electric Signal Co. v. Hall Signal Co., 114 U. S., at page 98;
McClain v. Ortmayer, 141 U. S., at page 425.

In the last named case of McClain v. Ortmayer, decided by this Court in 1891, in referring to plaintiff's contention in that case and in connection with the reference to its early decision in the said case of Vance v. Campbell, this Court says what is peculiarly applicable to the erroneous decision of Judge Burns in respect to this Smith patent and to the fallacious contention of petitioner's counsel in the case at bar in respect to Claims 1 and 2 of said Smith patent, this Court stating in its opinion in said case of McClain v. Ortmayer, at page 425 of 141 U. S., as follows:

> "It is true that, in a case of doubt, where the claim is fairly susceptible of two constructions, that one will be adopted which will preserve to the patentee his actual invention; but if the language of the specification and claim shows clearly what he desired to secure as

a monopoly, nothing can be held to be an infringement which does not fall within the terms the patentee has himself chosen to express his invention. The principle announced by this Court in Vance v. Campbell, 1 Black 427, that, where a patentee declares upon a combination of elements which he asserts constitute the novelty of his invention, he cannot in his proofs abandon a part of such combination and maintain his claim to the rest, is applicable to a case of this kind where a patentee has claimed more than is necessary to the successful working of his device.

Applying these familiar principles to the case under consideration, we are forced to the conclusion that the curved hook of the defendant is not an infringement of the double spring described in the plaintiff's specification and claim. While a single spring or hook embracing the fore wale of a collar may be equally as efficacious, the patentee is no more at liberty to say that the spring encircling the after wale is immaterial and useless than was the patentee in Vance v. Campbell to discard one of the elements of his combination upon the same ground."

In the last-named case of McClain v. Ortmayer (141 U. S., 419-429), this Court announces and reaffirms principles applicable to the construction of claims of letters patent, all of which were either ignored or misapplied by Judge Burns in the said case in the Fifth Circuit in his consideration of the claims of the three Smith letters patent in suit as applied to the defendants' devices in that case, which sound and settled principles petitioners' counsel would have this Court ignore in the case at bar.

This Court in the said case of McClain v. Ortmayer, in considering plaintiff's patent and defendants' device before it in that case and by reference to several of its earlier decisions, lays down the following principles at pages 423-

425 of 141 U. S., portions of the following quotation being purposely italicized by us to show how Judge Burns in his decision in the said case in the Fifth Circuit has misapplied the law to the facts in the case before him, and also, without lawful power, has taken liberties in the construction of the very definite claims of the Smith letters patent in suit, so as to make such claims include *more than their language fairly imports*—a liberty which this Court has repeatedly declared that the Courts have not the power to exercise:

"It is evident from this patent and from the entire testimony that the defendants made use of a single hook D, embracing the front rool of the collar only, while the appellant McClain has limited himself, perhaps unnecessarily, to the elastic springs s s, *which the drawings and the whole tenor of the specification show to be double and intended to be clasped around both the fore and after wales of the collar.* While the patentee may have been unfortunate in the language he has chosen to express his actual invention, and may have been entitled to a broader claim, *we are not at liberty, without running counter to the entire current of authority in this court, to construe such claims to include more than their language fairly imports.* Nothing is better settled in the law of patents than that the patentee may claim the whole or only a part of his invention, *and that if he only describe and claim a part, he is presumed to have abandoned the residue to the public.* The object of the patent law in requiring the patentee to 'particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery,' is not only to secure to him all to which he is entitled, *but to apprise the public of what is still open to them.* The claim is the measure of his right to relief, and while the specification may be referred

to to limit the claim, it can never be made available to expand it. Thus in Keystone Bridge Company v. Phoenix Iron Company, 95 U. S. 274, 278, the manufacture of round bars, flattened and drilled at the eye, for use in the lower chords of iron bridges, was held not to be an infringement of a patent for an improvement in such bridges where the claim in the specification described the patented invention as consisting in the use of wide and thin drilled eye bars applied on edge. In delivering the opinion of the court, Mr. Justice Bradley observed: 'It is plain, therefore, that the defendant company, which does not make said bars at all' (that is, wide and thin bars), 'but round or cylindrical bars, does not infringe this claim of the patent. *When a claim is so explicit, the courts cannot alter or enlarge it.* If the patentees have not claimed the whole of their invention, and the omission has been the result of inadvertence, they should have sought to correct the error by a surrender of their patent and an application for a reissue. * * * *But the courts have no right to enlarge a patent beyond the scope of its claim as allowed by the Patent Office*, or the appellate tribunal to which contested applications are referred. When the terms of a claim in a patent are clear and distinct (as they always should be), the patentee, in a suit brought upon the patent, is bound by it. * * * He can claim nothing beyond it.'

Similar language is used in Railroad Company v. Mellon, 104 U. S. 112, in reference to a patented locomotive wheel. In Masury v. Anderson, 11 Blatchford 162, 165, it was said by Mr. Justice Blatchford: 'The rights of the plaintiff depend upon the claim in his patent, *according to its proper construction, and not upon what he may erroneously suppose it covers.*' "

The decision of this Court in McClain v. Ortmayer, *supra*, and the principles announced by this Court in our

quotations from that decision *supra*, as well as reaffirmance of the doctrine laid down by this Court in Keystone Bridge Co. v. Phoenix Iron Co., 95 U. S., 274, are cited and referred to by this Court in numerous later decisions, as for example in the following cases:

Deering v. Winona Harvester Works, 155 U. S., at page 296;
Cimiotti Unhairing Co. v. Am. Fur Ref. Co., 198 U. S., at page 410;
Motion Picture Co. v. Universal Film Co., 243 U. S., at page 510.

In the case of Cimiotti Unhairing Co. v. American Fur Ref. Co., *supra*, 198 U. S., at page 410, this Court holds as follows:

> "In making his claim the inventor is at liberty to choose his own form of expression, *and while the courts may construe the same in view of the specifications and the state of the art, they may not add to or detract from the claim.* And it is equally true that as the inventor is required to enumerate the elements of his claim, *no one is an infringer of a combination claim unless he uses all the elements thereof.* Shepard v. Carrigan, 116 U. S., 593, 597; Sutter v. Robinson, 119 U. S., 530, 541; McClain v. Ortmayer, 141 U. S., 419, 425; Wright v. Yuengling, 155 U. S., 47; Black Diamond Co. v. Excelsior Co., 156 U. S., 611, 617; Walker on Patents, Sec. 349. This principle is particularly important when we come to consider the 'stationary card above the stretcher-bar,' *an element of the eighth claim.*" (Italics ours.)

In Motion Picture Co. v. Universal Film Co., *supra*, at page 510 of 243 U. S., after referring to the patent statutes, this Court lays down the following rule long estab-

lished by it as applicable to the patent law and the construction of patents, a part of what we are about to quote having been purposely italicized by us:

> "1st. The scope of every patent is limited to the invention described in the claims contained in it, *read in the light of the specification.* These so mark where the progress claimed by the patent begins and where it ends that they have been aptly likened to the description in a deed, which sets the bounds to the grant which it contains. *It is to the claims of every patent, therefore, that we must turn when we are seeking to determine what the invention is, the exclusive use of which is given to the inventor by the grant provided for by the statute,*—'He can claim nothing beyond them.' Keystone Bridge Co. v. Phoenix Iron Co., 95 U. S., 274; Railroad Co. v. Mellon, 104 U. S., 112, 118; Yale Lock Mfg. Co. v. Greenleaf, 117 U. S., 554, 559; McClain v. Ortmayer, 141 U. S., 419, 424."

As to the doctrine announced and applied by this Court in Keystone Bridge Co. v. Phoenix Iron Co., 95 U. S., 274, 278, cited in McClain v. Ortmayer, at page 424 of 141 U. S., *supra*, that doctrine and that Keystone Bridge case are expressly followed and cited by this Court in many of its later decisions, to some of which we shall now refer, as follows:

> Railroad Co. v. Mellon, 104 U. S., at page 118;
> Duff v. Sterling Pump Co., 107 U. S., at page 639;
> Yale Lock Co. v. Greenleaf, 117 U. S., at page 559;
> White v. Dunbar, 119 U. S., at page 52;
> McClain v. Ortmayer, 141 U. S., at page 424, supra;
> Coupe v. Royer, 155 U. S., at page 576;
> Motion Picture Co. v. Universal Film Co., 243 U. S., at page 510;
> Minerals Separation v. Butte etc. Mining Co., 250 U. S., at page 347.

All the cases last above cited and referred to hold, to use the very language of this Court used in deciding them: "The scope of letters patent must be limited to the invention covered by the *claim*, and while the *claim* may be *illustrated*, it cannot be *enlarged* by language used in other parts of the specification" (the italics are ours).

The same principles as those announced by this Court in Keystone Bridge Co. v. Phoenix Iron Co., *supra*, which principles are strictly applicable to the facts in the case at bar in respect to the Smith patents relied upon by petitioner in this case, are announced and applied by this Court in Weber Electric Co. v. Freeman Electric Co., 256 U. S., 668, 677, where this Court, referring to its decisions in Shepard v. Carrigan, 116 U. S., 593, 598, and Hubbell v. United States, 179 U. S., 77, 80, expressly holds: that, where it appears that the patentee, in order to obtain his patent, has presented and obtained a specifically narrow claim, he may not afterwards "*by construction or resort to the doctrine of equivalents*" *give to it a larger scope which it might otherwise have had but for the limitations and restrictions stated in the claim and by which the patentee has undertaken to define precisely what he claims as his invention.*

So, also, in the quite recent decision of this Court in I. T. S. Co. v. Essex Co., 270 U. S., 429-455, the same principles as those just stated above and which are strictly applicable to the facts in this case and to the history of the Smith letters patent in suit are re-affirmed by this Court.

The fact that Judge Burns in his opinion should have so thoroughly misunderstood, or misapplied, the law to the facts in the case before him is all the more surprising in view of what we are about to say.

The decision of this Court in the case of White v. Dunbar, 119 U. S., 47, was rendered in 1886, on appeal from

the decree of the then Circuit Court of the United States for the Eastern District of Louisiana, in a suit for infringement of letters patent. In that case this Court, in reversing the decree of the Court below, which had found the patent valid and infringed, and in laying down rules for the proper interpretation of letters patent, declared as follows, at pages 51-52:

> "Some persons seem to suppose that a claim in a patent is like a nose of wax which may be turned and twisted in any direction, by merely referring to the specification, so as to make it include something more than, or something different from, what its words express. The context may, undoubtedly, be resorted to, and often is resorted to, for the purpose of better understanding the meaning of the claim; but not for the purpose of changing it, and making it different from what it is. The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms. This has been so often expressed in the opinions of this court that it is unnecessary to pursue the subject further. See Keystone Bridge Co. v. Phoenix Iron Co., 95 U. S., 274, 278; James v. Campbell, 104 U. S., 356, 370".

Since then and until the District Court for the Eastern District of Louisiana rendered its opinion (by Burns, J.) in the said case of Smith v. American Electric Rabbit Racing Assn., 21 Fed. (2nd), 366, the principle announced by this Court in White v. Dunbar, *supra*, and in other decisions hereinbefore cited seems to to have been recognized and applied in the Fifth Circuit. For example, in the case of Dry Hand Mop Co. v. Squeez-Ezy Mop Co., decided Feb. 17, 1927, reported in 17 Fed. (2nd). 465, the C. C. A.

for the 5th Circuit not only expressly cites and follows the said decision of this Court in White v. Dunbar, *supra*, but holds (see page 466 of 17 Fed., 2nd Series) as follows, the italics in the following quotation being our own:

> "(1) Patent numbered 1,426,084 contained six claims. It was a combination patent; none of the six claims being new. *Its novelty, if any, was altogether in the combination.* The law is conceded by counsel to be that, to constitute infringement of such a patent, *the infringer must be shown to have used every ingredient of the combination. An omission of any one element prevents infringement.* Central Foundry Co. v. Coughlin (C. C. A.), 141 F. 91; Dunbar v. Meyers, 94 U. S. 187, 24 L. Ed. 34; Roberts v. Nail Co. (C. C.), 53 F. 916." • • •
>
> "(4) The record also shows clearly that plaintiff's assignor was required to, and did in fact, at the behest of the Patent Office, change his first claim by substituting 'beyond' for 'over' in that claim, and that he voluntarily carried the same change into claims 2, 3, and 4. *Claims containing self-imposed limitations are not infringed by structures which omit the self-imposed restrictions.* Keystone Bridge Co. v. Phoenix Iron Co., 95 U. S., 274, 24 L. Ed. 344; Burns v. Meyer, 100 U. S., 671, 25 L. Ed. 738; White v. Dunbar, 119 U. S., 47, 7 S. Ct., 72, 30 L. Ed. 303; Morse Chain Co. v. Link Belt Co. (C. C. A.), 189 F., 584; Thacher v. Transit Construction Co. (D. C.), 228 F., 905. Affirmed Id. (C. C. A.), 234 F. 640. The patentee, and plaintiff, his assignee, are *precluded from invoking the principle of equivalency as against defendant's use of a cushion formed by bringing the loops of the strand together over the end of the mop handle.*"

Nevertheless and notwithstanding the fact that Judge Burns in his said opinion refers to the decision of the C. C. A. for the 5th Circuit in the said case of Dry Hand Mop

Co. v. Squeez-Ezy Mop Co. (see Judge Burns' opinion, at page 369 of 21 Fed., 2nd Series), and notwithstanding the fact that the principles announced by the C. C. A. for the 5th Circuit in the said Dry Hand Mop Co. case, quoted from *supra*, were strictly applicable to the suit in the 5th Circuit before Judge Burns, he seems to have utterly failed to recognize that those principles and the decisions of the Supreme Court cited and quoted from by the C. C. A. for the 5th Circuit in the said Dry Hand Mop Co. case were strictly applicable to the facts in the case before him. He ignored, or failed to apply, those principles to the facts in the case before him, and on appeal to the C. C. A. for the 5th Circuit, notwithstanding what that Court had previously decided in the Dry Hand Mop case *supra*, that Court affirmed the "*conclusions*" which had been reached by Judge Burns, and thereupon affirmed the interlocutory decree which the District Court had entered in that case of Smith v. American Electric Rabbit Racing Assn.

Before dismissing our consideration of the said opinion of Judge Burns in 21 Fed. (2nd), 366-376, inasmuch as Judge Burns in his said opinion refers to and invokes the decision of this Court in Winans v. Denmead, 15 Howard, 330, we deem it proper to consider that decision of this Court, in order to show that, in its facts and in its application of the law to those facts, this Court has decided nothing warranting the conclusions that the defendants' devices in the said case in the 5th Circuit infringed the Smith letters patent in that suit—the same three Smith letters patent which are before this Court in the case at bar.

THE CASE OF WINANS V. DENMEAD.

The opinions of this Court in the above case, reported in 15 Howard, pages 338 to 348, were delivered in 1853. As then constituted, the Chief Justice of this Court was Mr. Justice Taney, and the Associate Justices were Justices M'Lean, Wayne, Catron, Daniel, Nelson, Grier, Curtis and Campbell. The Court was divided in the determination of the only issue presented in that case—the issue of *infringement*—, the *validity* of the patent not being questioned, as the Court points out in its opinion. Mr. Justice Curtis delivered the majority opinion, finding the patent infringed; but there was a vigorous dissenting opinion, by Campbell, J., in which dissent Taney, C. J., and Justices Catron, Daniel and Campbell concurred.

The plaintiff's patent in that suit was a patent granted to plaintiff on the 26th of June, 1847, and was granted when the Patent Act of 1836 was in force, to which last named Act this Court refers in its opinion in that case, at page 341 of 15 Howard.

Section 6 of the Patent Act of 1836 is set forth, among other places, in the 5th edition of Walker on Patents, at pages 862 and 863 thereof. The provisions of that Sec. 6 of the Patent Act of 1836, in respect to the requirements of the specification and claims, were not quite as strict as the provisions of the present statute on that subject—the provisions of Sec. 4888 R. S. U. S., the statute now in force and which was in force at the time the Smith letters patent in suit were applied for and granted.

To point out the exact difference, in these respects, between Sec. 6 of the Patent Act of 1836 and Sec. 4888 R. S. U. S., we set forth below, in different columns, the relevant part of Sec. 6 of the Patent Act of 1836 and Sec. 4888 R. S. U. S.

RELEVANT PART OF SEC. 6 OF THE PATENT ACT OF 1836.

* * * "But before any inventor shall receive a patent for any such new invention or discovery, he shall deliver a written description of his invention or discovery, and of the manner and process of making, constructing, using and compounding the same, in such full, clear, and exact terms, avoiding unnecessary prolixity, as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of any machine, he shall fully explain the principle, and the several modes in which he has contemplated the application of that principle or character by which it may be distinguished from other inventions; and shall particularly specify and point out the part, improvement, or combination, which he claims as his own invention or discovery. He shall, furthermore, accompany the whole with a drawing or drawings, and written references, where the nature of the case admits of drawings," * * *

SEC. 4888 R. S. U. S.

"Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and *distinctly claim* the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor." (Italics ours.)

It may be worthy of note that the words "*distinctly claim*", present in Sec. 4888 R. S. U. S., are not present in the above quoted excerpt from Sec. 6 of the Patent Act of 1836; indeed, those words "*distinctly claim*" are not present at all in Sec. 6 of the Patent Act of 1836. It is fair to presume that Congress had a purpose in inserting the words "*distinctly claim*" in Sec. 4888 R. S. U. S.

It should further be noted that, so far as appears from the majority and dissenting opinions of this Court in the case of Winans v. Denmead, the invention which Winans disclosed, described and illustrated in his patent was broadly new with him and involved a new principle of construction and operation, all as fully pointed out by the majority opinion of this Court in that case.

The new and valuable invention disclosed by plaintiff's patent in that case is thus set forth in the majority opinion, at page 339:

> "Without going into unnecessary details, or referring to drawings, it may be stated that the structure, described by this patent, is the body of a burden railroad car, made of sheet iron, the upper part being cylindrical, and the lower part in the form of a frustum of a cone, the under edge of which has a flange secured upon it, to which flange a movable bottom is attached. This bottom is made movable, in order to discharge the load through the aperture left by removing it.
>
> To understand the mode of operation introduced and employed by means of this form of the car body, it is only necessary to state, what appears on the face of the specification, and was testified to by experts at the trial as correct, that, by reason of the circular form of the car body, the pressure of the load outwards was equal in every direction, and thus the load

supported itself in a great degree; that, by making the lower part conical, this principle of action operated throughout the car, with the exception of the small space to which the movable bottom was attached; that, being conical, the lower part of the car could be carried down below the truck, between the wheels, thus lowering the center of gravity of the load; that the pressure outwards upon all parts of the circle being equal, the tensile strength of the iron was used to a much greater degree than in a car of a square form; and finally, that this form of the lower part of the car facilitated the complete discharge of the load through the aperture, when the bottom was removed."

The claims of the patent as set forth in the majority opinion of this Court were as follows, at page 341:

"What I claim as my invention, and desire to secure by letters-patent, is making the body of a car for the transportation of coal, etc., in the form of a frustum of a cone, substantially as herein described, whereby the force exerted by the weight of the load presses equally in all directions, and does not tend to change the form thereof, so that every part resists its equal proportion, and by which, also, the lower part is so reduced as to pass down within the truck frame and between the axles, to lower the center of gravity of the load without diminishing the capacity of the car as described.

I also claim extending the body of the car below the connecting pieces of the truck frame, and the line of draft, by passing the connecting bars of the truck frame, and the draft bar, through the body of the car, substantially as described."

In that case, the defendant's car, in all respects, corresponded with the car described and claimed in plaintiff's patent, except that the body of the car, instead of being

in the form of the frustum of a cone (the particular form illustrated, described and claimed in plaintiff's patent) was of octagonal form, with an octagonal pyramidical base. In finding that, except as to the particular form or contour of the body of the car, the defendant had copied the new invention of plaintiff's patent, and that, in the particular circumstances of that case, as defendant had used every element, or the clear mechanical equivalent of every element, of the broadly new invention made and claimed by the patentee, and therefore had infringed that patent, the majority opinion of this Court states, at page 344 of 15 Howard, as follows:

> "How is a question of infringement of this patent to be tried? It may safely be assumed, that neither the patentee nor any other constructor has made, or will make, a car exactly circular. In practice, deviations from a true circle will always occur. How near to a circle, then, must a car be, in order to infringe? May it be slightly elliptical, or otherwise depart from a true circle, and, if so, how far?
>
> In our judgment, the only answer that can be given to these questions is, that it must be so near to a true circle as substantially to embody the patentee's mode of operation, and thereby attain the same kind of result as was reached by his invention. It is not necessary that defendant's cars should employ the plaintiff's invention to as good advantage as he employed it, or that the result should be precisely the same in degree. It must be the same in kind, and effected by the employment of his mode of operation in substance."

After all, it may be seriously questioned whether there was any real difference, even as to form, between the device illustrated and described in plaintiff's patent in that case and that of the defendant. In discussing the said decision

of this Court and speaking of this very question, the learned C. C. A. for the 6th Circuit, in the case of D'Arcy Spring Co. v. Marshall etc. Co., 259 Fed., at page 238, states:

> "In Winans v. Denmead, 15 How. 341, 14 L. Ed. 717, a claim to the frustum of a cone was held to include as an equivalent the frustum of an octagonal pyramid. It is doubtful whether there was so much discrepancy between the letter of the claim and the defendant's form as has been thought, since a cone is a pyramid with an infinite number of sides, or, as recited in the opinion, 'polygon of many sides would be equivalent to a circle'; but, passing by this feature of identity, it is clear that the difference was merely in form, and that, in operation and functions and effect, the two were identical. The difference in form did not stand for anything else, and the rule of equivalency so strict as to exclude from the monopoly one form and include the other would tend to raise doubt as to the existence of any patentable invention."

In view of the facts before this Court in Winans v. Denmead, nothing that this Court said and decided in that case is warrant for holding that where the machine or device, as illustrated, described and claimed in plaintiff's patent (interpreting the claims in the light of the thing as disclosed in the specification, as this Court has repeatedly held must be done) specifies a certain number of elements, with functions, purposes or conditions assigned to such elements (as, for example, a wheel at the outer edge of the arm, to support the arm at that point, the arm being *hinged* at its inner end, to permit of up and down play or movement of the arm independently of the movement of the car)—that, in such a case (the case at bar and the case before Judge Burns), a device or machine which does

not have in it, or as part of it, such element (said wheel, in this case) and is *not hinged* to the car, and has not, in its arm, said capacity of up and down movement independently of the movement of the car, nevertheless infringes claims which specifically call for a structure having such element and such conditions and capacities.

To so interpret this Court's opinion in Winans v. Denmead, *supra* (as Judge Burns, in effect, did in his opinion in 21 Fed., 2nd, 371), is not only to misinterpret that decision of this Court, but also to decide contrary to and in the very teeth of the rule and principles so clearly laid down by this Court in Vance v. Campbell, 1 Black (66 U. S.), 427, and followed in the host of this Court's later decisions reaffirming the doctrine of Vance v. Campbell, all of which decisions we have so fully reviewed, cited and quoted from *supra*.

It would, therefore, seem clear, not only that Judge Burns in his said opinion, which opinion is so much relied upon by petitioner here, grossly erred, not only in his reasoning, as applied to the facts in the case before him, but also in his conclusions; but that the C. C. A. for the Fifth Circuit, in agreeing with the erroneous "*conclusions*" reached by Judge Burns, thereby affirming his interlocutory decree in that case, also clearly erred.

On the other hand, it would seem clear that the Courts below in the case at bar, in refusing to follow the said opinion of Judge Burns, or the C. C. A. for the Fifth Circuit, which affirmed the decree entered by Judge Burns, decided rightly and in harmony with the decisions of this Court in the analogous cases cited and referred to herein.

And it also appears, from what we have said *supra*, that in its opinion in Magic City Kennel Club, Inc., et al., Appellants, v. Smith (a suit by this petitioner in which two

of the identical Smith patents—Nos. 1,379,224 and 1,507,-440—before this Court in the case at bar were in issue), the C. C. A. for the Tenth Circuit (see 38 Fed., 2nd, 170) decided rightly, when, in refusing to follow said opinion of Judge Burns, or the decision of the C. C. A. for the Fifth Circuit, it held, in harmony with the decisions of this Court in analogous cases, that neither of said patents had been infringed by devices substantially identical with defendants' devices in said case in the Fifth Circuit and with respondents' devices in the case at bar.

PAUL BAKEWELL,
Solicitor for Respondents.

St. Louis, February, 1931.